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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91200643
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TRADEMARK

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Trademark Opposition of:

Mark: BUCK ROGERS
Serial No.: 77/650,082
Filed: January 15, 2009

Opposition No. 91200643

Dille Family Trust,
 Opposer

v.

Nowlan Family Trust,
 Applicant

**APPLICANT, NOWLAN FAMILY TRUST'S
FINAL BRIEF ON THE MERITS**

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Applicant Nowlan Family Trust (hereinafter “Applicant”) hereby submits its Final Brief on the Merits in the trial of the above-titled matter involving Opposer Dille Family Trust (hereinafter “Opposer”) pursuant to 37 C.F.R. § 2.128(a)(1).

As outlined herein, Opposer has failed to show any basis for its Opposition of Applicant's subject trademark application, and has failed to comply with the Trademark Trial and Appeal Board’s (“Board’s”) rules. Opposer has failed to carry its threshold burden, and its opposition must be dismissed.

I. INTRODUCTION

Since the commencement of this proceeding, Opposer has claimed ownership and “continuous and extensive use” of the mark BUCK ROGERS (“the Mark”) dating back to 1929. Given the stridency of Opposer’s position and the length and extent of the claimed use, one would expect Opposer to be able to provide a mass of evidence establishing such alleged “widespread use” since 1929. However, the opposite is true, as Opposer has failed to establish:

1. Any use of the Mark dating back to its claimed use date of 1929.
2. Any use of the Mark prior to Applicant’s priority date of January 15, 2009.
3. A specific date or even year of first use of the Mark.
4. Any proof of actual use of the Mark in commerce at any time.
5. A chain of title establishing ownership of the Mark dating back to the claimed first use date of 1929.

Instead, Opposer has primarily relied upon a series of “agreements” purported to be licenses of some kind, but which for the most part are incomplete documents dated *after* Applicant’s priority date. Most significantly, none of the relied upon documents show that Opposer or its purported licensees ever used the mark in commerce, as defined by 15 U.S.C. § 1127, on a single good or service. Opposer fails to ever explain the significance of its evidence or establish that a single good or service was offered in interstate commerce under the Mark. Simply put, Opposer’s alleged evidence lacks any corroborating documents and does not evidence a single sale by it or a third party. No competent testimony by any witness with personal knowledge of use of the Mark by or on behalf of Opposer was introduced.

Significantly, most of the evidence relied upon by Opposer is dated after Applicant’s priority date, and thus, cannot support its claims. This *ex post facto* burst of activity is not coincidental and is reflective of Opposer’s attempts to manufacture rights where none ever existed or where such rights have been long since abandoned. However, a mad scramble to invent rights, after the date of Applicant’s subject trademark application, cannot substitute for competent evidence.

In essence, Opposer is asking the Board to assume that it has rights in the Mark without bothering to go to the trouble of actually proving its case.

II. STATEMENT OF FACTS

On January 15, 2009, Applicant filed an intent-to-use application,

Application Serial No. 77/650,082, for the mark BUCK ROGERS, seeking registration in International Class 009 for:

Motion picture films and motion picture films for broadcast on broadcast mediums; audio tapes, audio-video tapes, audio video cassettes, audio video discs, and digital versatile discs featuring music, comedy, drama, action, adventure, and/or animation; stereo headphones; batteries; cordless telephones; audio cassette and CD players; CD ROM computer game discs; telephone and/or radio pagers; short motion picture film mediums; video cassette recorders and players, compact disc players, digital audio recorders and players; radios; mouse pads; eyeglasses, sunglasses and cases therefore; game equipment; video and computer game programs; video game cartridges and cassettes; cellular telephone accessories; encoded magnetic cards; Printed matter and paper goods, namely, books, comic books, magazines; stationery, writing paper, envelopes, notebooks, diaries, note cards, greeting cards, trading cards; lithographs; pens, pencils, cases therefor, erasers, crayons, markers, colored pencils, painting sets for children, chalk and chalkboards; decals, heat transfers; posters; mounted and/or unmounted photographs; book covers, book marks, calendars, gift wrapping paper; paper party favors and paper party decorations; printed patterns for costumes, pajamas, sweatshirts and t-shirts; bedding; Toys; sporting goods, games, clothing, luggage, bags, household items, watches, jewelry, dishware; candy; entertainment services; entertainment services, namely, an on-going series provided through broadcast mediums including television, webcasts, and radio broadcasts

The application was amended and published for Opposition in the *Official Gazette* on June 11, 2011 with the following identification of goods and services:

International Class 009: Motion picture films about science fiction, fantasy heroism and action adventure; science fiction, and motion picture films about fantasy heroism and action adventure for broadcast on broadcast mediums; audio tapes, audio-video tapes, audio video cassettes, audio video discs, and digital versatile discs featuring music, comedy, drama, action, adventure, and animation; stereo headphones; batteries; cordless telephones; audio cassette and CD players; CD ROM computer game discs; telephone and radio pagers; short motion picture films about science fiction, fantasy heroism and action adventure and adventure; video cassette recorders and players, compact disc players, digital audio recorders and players; radios; mouse pads; eyeglasses,

sunglasses and cases therefore; game equipment, namely, video game machines for use with televisions, hand-held electronic games adapted for use with television receivers only and player operated electronic controllers for electronic video game machines; video and computer game programs; video game cartridges and cassettes; cellular telephone accessories, namely, cell phone covers, batteries, fitted plastic films known as skins for covering and providing a scratch proof barrier, decorative charms, decorative ornaments, headsets, boosters, connectivity kits and memory cards; encoded magnetic cards

International Class 016: Printed matter and paper goods, namely, books featuring science fiction, fantasy heroism and action adventure, comic books, magazines featuring science fiction, fantasy heroism and action adventure; stationery, writing paper, envelopes, notebooks, diaries, note cards, greeting cards, trading cards; lithographs; pens, pencils, cases therefor, erasers, crayons, markers, colored pencils, painting sets for children, chalk and chalkboards; decals, heat transfers; posters; mounted and unmounted photographs; book covers, book marks, calendars, gift wrapping paper; Paper party decorations; Printed patterns for costumes, pajamas, sweatshirts and t-shirts; paper party favors

International Class 025: Clothing, namely, pajamas, t-shirts, shirts, jumpers, sweatshirts, vests, coats, jackets, overcoats, trousers, shorts, socks, gloves, ties, scarves, skirts, underwear, footwear; headgear, namely, hats, caps, head scarves, baseball caps and headbands, clothing accessories, namely, belts, gloves, suspenders, sweat bands, straps for bras

International Class 028: Toys, namely, musical toys, inflatable toys, electric action toys, punch toys, plush toys, talking toys, toy cars, role-playing toys in the nature of play sets for children to imitate real life occupations, toy boats, toy airplanes, toy weapons, toy rocket ships, construction toys, toy putty, toy scooters, toy action figures and accessories for use with toy action figures, toy model vehicles, water squirting toys and toy model space craft, toy building blocks, toy model hobby craft kits comprising paints, beads, ceramics, plastics, crayons, stencils, toy model vehicles and related accessories sold as a units, toy modeling dough kits comprising toy modeling dough, molds and accessories for use therewith sold as units, toy vehicles, toy weapons, toy model vehicles and accessories therefor sold as a unit, wind-up toys and miniature toy helmets; sporting goods, namely, beach balls, playground balls, soccer balls, sport balls, baseball balls, basketball balls, baseball bats, and baseball gloves; games, namely, action type

target games, board games, card games, hand held units for playing electronic games other than those adapted for use with an external display screen or monitor, virtual arcade shooting game machines, trading card games, parlor games, action skill games, coin operated and non-coin operated pinball machine games, stand alone video game machines, collectible card games, and collectible miniature board games

International Class 041: Entertainment services, namely, an on-going series provided through broadcast mediums, namely, television, webcasts, and radio broadcasts

On July 12, 2011, Opposer filed a Notice of Opposition against Applicant. As grounds for the Opposition, Opposer asserted that (1) Applicant's use of the applied-for mark is likely to cause confusion, mistake, or deception in violation of Section 2(d) of the Lanham Act (15 U.S.C. § 1052(d)) and (2) Applicant's use of the applied-for mark is likely to cause dilution, in violation of Section 43(a) and/or (c) of the Lanham Act (15 U.S.C. § 1125(a) and (c)).

III. STATEMENT OF ISSUES

- A.** Whether Opposer has standing to bring this action.
- B.** Whether Opposer has waived its claim to dilution.
- C.** Whether Opposer has met its burden of proving priority of use by a preponderance of the evidence.
- D.** Whether Opposer is entitled to preclude registration of Applicant's mark without evidence that Applicant lacked the requisite *bona fide* intent to use its BUCK ROGERS mark at the time it filed its trademark application.
- E.** Whether Opposer has met its burden of establishing likelihood of confusion

IV. DESCRIPTION OF THE RECORD

The Record includes Applicant's application file for Serial No. 77/650,082 and the pleadings. 37 C.F.R. § 2.122(b). The Record¹ also comprises the following:

A. The following trial testimony depositions (certified transcripts and exhibits) taken in this opposition proceeding and filed with the Trademark Trial and Appeal Board (the "Board"):

1. March 25, 2014 Deposition of Louise A. Geer, referred to as "Geer Test. Dep. at ____," and the accompanying exhibits (Nos. 1-8, 13, 14, 19, 31, 33, 34, 36, 37, 39, 40, 42, 43, 50, 51, 53, and 57-62) referred to as "Geer Exhibit ____."

B. Opposer's Revised Notice of Reliance², dated October 8, 2014, pursuant to which the following evidence as described by Opposer was filed by Opposer for introduction into evidence in this opposition proceeding:

1. Summary from USPTO.gov website for Opposer's application number 77/831,213 for the mark "Buck Rogers"

2. Summary from USPTO.gov website for Opposer's application number 77/831,393

3. Copy of pages 300-303 from *Previews* November 2012 edition

¹ Applicant sets forth its specific objections to Opposer's Revised Notice of Reliance, the Geer Deposition and Geer Deposition in Applicant's Objections to the Evidence Presented by Opposer in Appendix A attached hereto.

² Opposer filed its first Notice of Reliance on March 26, 2014. However, pursuant to the Board's October 3, 2014 Order, most of the documents were stricken from the Notice of Reliance and Opposer was instructed file a revised Notice of Reliance.

featuring Buck Rogers comic books and books for sale.³

V. ARGUMENT

A. Opposer Has Failed to Establish Standing in this Proceeding

“[A] petitioner’s allegations alone do not conclusively establish standing.” *Ritchie v. Simpson*, 170 F.3d 1092, 1099, 50 USPQ2d 1023 (Fed. Cir. 1999). “[T]he facts alleged which establish standing are part of the petitioner’s case, and ... must be affirmatively proved.” *Id.* (citing *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 1028, 213 U.S.P.Q 185, 189 (CCPA 1982)).

In its brief, Opposer argues that its standing is based on: (1) prior Registration Nos. 0714184 and 1555871, (2) use in commerce as early as 1929, and (3) Opposer’s Application Nos. 77/831393 and 77/831213. (Opposer’s Brief at pg. 3-4). However, other than providing conclusory statements, Opposer has failed to meet the very basic, initial element of affirmatively proving or even sufficiently explaining its alleged grounds for standing.

1. Opposer’s prior cancelled registrations cannot establish a valid ground for standing

Although Opposer makes much of its canceled registrations, Nos. 0714184 and 1555871, Opposer has conspicuously failed to make either registration of record in this case.⁴ Moreover, even if Opposer had properly submitted the registrations

³ Applicant filed a Notice of Reliance on May 27, 2014. Applicant amended its Notice of Reliance on November 17, 2014 by deleting the sole item of evidence it submitted which consisted of a copy of the TSDR status page for its application Serial No. 77/650,082.

⁴ By way of background, in Cancellation No. 92051659, Petitioner (Applicant) sought cancellation of Registration Nos. 0714184 and 1555871 on the grounds of

into evidence, Opposer has acknowledged, as it must, that both registrations were canceled. (Opposer's Brief at pg. 5). It is well established that a cancelled registration is not evidence of any rights in a trademark. *In re Grey Hosiery Mills*, 137 USPQ 455 (T.T.A.B. 1963); *General Precision, Inc. v. Thein*, 135 USPQ 478 (T.T.A.B. 1962) *aff'd*, 140 USPQ 610 (C.C.P.A. 1964). *See also* Trademark Board Manual of Procedure ("TBMP") §704.03(b)(1)(A) ("Although an expired or cancelled registration may be made of record ... such a registration is not evidence of anything except that the registration issued; it is not evidence of any presently existing rights in the mark shown in the registration, or that the mark was ever used."). Manifestly, a cancelled registration has no probative value. *Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1490 (TTAB 2007).

Opposer has not cited to any additional valid and subsisting registrations in its Brief. Thus, Opposer has failed to affirmatively prove standing through any registered mark.

2. Opposer has not properly introduced evidence that its pending applications were refused pending the outcome of this proceeding

In order for a pending application to serve as basis for standing in an opposition, and for the Board to rely upon that application in determining plaintiff's standing, it must be properly introduced into evidence, and the fact that it was

fraud, for knowingly and intentionally providing false statements on declarations regarding Opposer's use of the mark in commerce, and abandonment. Judgment was entered against the respondent (Opposer) pursuant to Trademark Rule 2.134(a), because the respondent applied to cancel its involved registrations under Section 7(e) without the written consent of every adverse party to the preceding. *See* Docket No. 20 in Cancellation No. 92051659.

refused pending outcome of a proceeding must be documented and placed into evidence. *Giersch v. Scripps Networks*, 90 USPQ2d 1020, 1022 (TTAB 2009).

Again, Opposer has failed to meet the basic element of standing by properly establishing by testimony or documentation that its pending applications were refused and suspended pending the outcome of this proceeding. Opposer merely states that it is “the owner of ... current Application Nos. 77/831383 and 77/831213” and alleges that “it is likely to be damaged by Applicant’s registration of the Mark.” (Opposer’s brief at pg. 4). These conclusory statements do not meet the Board’s test. Thus, Opposer has failed to affirmatively prove standing through a currently pending application.

3. Opposer has failed to establish prior use of the mark and has thereby failed to establish standing on that basis

An opposer may establish standing based on prior common law use of a mark. *See e.g., Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1106 (TTAB 2007). However, as discussed above, “[a] petitioner’s allegations alone do not conclusively establish standing.” *Ritchie*, 170 F.3d at 1099. “[T]he facts alleged which establish standing are part of the petitioner’s case, and ... must be affirmatively proved.” *Id.* (citing *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 1028, 213 USPQ 185, 189 (CCPA 1982)). Moreover, an opposer that fails to prove any common law rights in its pleaded mark has failed to demonstrate its standing or that it is entitled to any relief under its asserted claim of likelihood of confusion. *Sterling Jewelers Inc. v. Romance & Co.*, 110 USPQ2d 1598, 1602 (T.T.A.B 2014).

Opposer's Notice of Opposition claims, without elaboration, continuous use of the Mark in commerce on "comic books, action figures, feature films, picture frames, belt buckles, key chains, resin statues, artwork, t-shirts, board games, computer software, internet television show license, DVDs, Blu-Ray video discs, and radio programs." See Opposer's Notice of Opposition, ¶ 12. However, Opposer has singularly failed to offer any evidence establishing: (1) prior use of the Mark with any of the relied upon goods in 1929, or any use on any of the goods/services prior to Applicant's priority date of January 15, 2009; or (2) ownership of the Mark dating back to 1929.

In order to support its claim to standing based on prior common law use, Applicant relies generally on the Geer Deposition and Geer Deposition Exhibits 6, 13, 14, 19, 33, 34, 36, 37, 39, 40, 40, 42, 43, 51, 53, and 59 - 61. As discussed in detail in Section V. C. 2. at 20, *supra*, this evidence does not establish use. Opposer has chosen to rely primarily on a collection of various uncorroborated agreements, rather than show actual *use* of the mark by Opposer or any third-party.

Turning to the Geer Deposition testimony, Opposer failed to provide any specific citations to that deposition transcript in support of its sweeping statements claiming either common law use or priority.⁵ Although it was a difficult and time consuming task, a full review of the Geer Transcript reveals that Opposer failed to provide evidence of any actual use prior to Applicant's priority date of January 15, 2009 other than Mrs. Geer's wholly uncorroborated and unsubstantiated

⁵ Louise Geer is Opposer's trustee as of July 1, 2011. Geer Test. Dep, at 4:7.

statements. As discussed in greater detail below, most of the proffered documents were fatally incomplete. Moreover, while a limited number of licenses do include attachments, those documents do not establish any use of any good or service by the purported licensees prior to Applicant's trademark applications. Essentially, Opposer would have the Board find that agreements alone show use of a trademark, which is the opposite of the controlling law.⁶ For at least these reasons and the reasons set forth in Section V. C. 2. at 20, Opposer has failed to establish prior use of the mark and therefore lacks standing to maintain this proceeding.⁷

B. Opposer Has Waived its Claim of Dilution

Opposer has failed to present any argument with respect to its claim of dilution in its Brief filed on February 10, 2015. A party waives its claims in an opposition proceeding if it fails to reference or argue that claim in its brief. TBMP §

⁶ Taking Opposer's position to its logical conclusion, two parties could simply exchange a license, and create trademark rights by virtue of that license, even if those parties never used the licensed mark in commerce.

⁷ In its "standing" argument, Opposer briefly notes that Applicant has alleged that it is the successor in interest and creator of the BUCK ROGERS mark and that Theresa Marie Nowlan assigned any rights the Nowlan Family Trust had in or about May 1942. See Opposer's Brief at 4. Applicant fails to see the relevance of this point because Applicant is relying solely on its subject intent-to-use application in this proceeding, rather than on any historical rights. In addition, the document itself is of no value because Opposer has failed to establish the authenticity of the document and that there is any privity or chain of title between the parties identified in the document and Opposer and Applicant. At the end of the day, this document is no different than the prior cancelled registrations -- it doesn't actually prove any subsisting rights in a trademark that might be relied upon in this proceeding. Moreover, even if Opposer established privity, the assignment is a naked transfer which does not convey to the assignee any goodwill associated with the Mark. A trademark cannot be sold or assigned apart from the good will it symbolizes. See 15 U.S.C. § 1060; *Pfizer, Inc. v. Hamerschlag*, 2001 TTAB LEXIS 729 (Trademark Trial & App. Bd. Sept. 27, 2001)(non-precedential opinion). As such, the assignment is also invalid as a prohibited assignment in gross. *Id.*

801.01; *Knight Textile Corp. v. Jones Investment Co.*, 75 USPQ2d 1313, 1314 n.4 (T.T.A.B. 2005) (where opposer presented no arguments in its brief regarding the claim of dilution, opposer is deemed to have waived the claim); *Swatch AG (Swatch SA) (Swatch Ltd.) v. M.Z. Berger & Co.*, 108 USPQ2d 1463, 1465 n.3 (T.T.A.B. 2013) (opposer's pleaded claims not argued in its brief deemed waived); *Central Garden and Pet Co. v. Dorskocil Manufacturing Co.*, 108 USPQ2d 1134, 1136 (T.T.A.B. 2013) (pleaded claim not argued in brief deemed waived). No evidence of dilution was presented, at any rate. Therefore, the Board should consider Opposer's claim of dilution waived.

C. Opposer Has Failed to Meet its Burden of Proof That it Has Priority in Common Law Rights Necessary to Challenge Applicant's Mark

To establish priority, an Opposer must show that that it has proprietary rights in the mark that it relies on to demonstrate likelihood of confusion. 15 U.S.C. § 1052; *Herbko International Inc. v. Kappa Books Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002). Generally, use in commerce constitutes the basis for establishing priority. However, proprietary rights may arise from a prior registration, a prior application, prior trademark or service mark use, prior use as a trade name, prior use analogous to trademark or service mark use, or any other use sufficient to establish proprietary rights. *Herbko International Inc.*, 308 F.3d 1156, 64 USPQ2d at 1378 (Fed. Cir. 2002).

Opposer, as the plaintiff in this proceeding, bears the burden of proof with respect to its claim of priority of use and likelihood of confusion. *See, e.g., Bose Corp.*

v. QSC Audio Products Inc., 63 USPQ2d 1303 (Fed. Cir. 2002) (“the burden of proof rests with the opposer ... to produce sufficient evidence to support the ultimate conclusion of [priority of use] and likelihood of confusion”); *Hoover Co. v. Royal Appliance Mfg. Co.*, 57 USPQ2d 1720, 1722 (Fed. Cir. 2001) (“in opposition proceedings, the opposer bears the burden of establishing that the applicant does not have the right to register its mark”); *Sanyo Watch Co., Inc. v. Sanyo Electric Co. Ltd. v. Sanyo Electric Co., Ltd.*, 215 USPQ 833 (Fed. Cir. 1982) (“[a]s the opposer in this proceeding, appellant bears the burden of proof which encompasses not only the ultimate burden of persuasion, but also the obligation of going forward with sufficient proof of the material allegations of the Notice of Opposition, which, if not countered, negates appellee's right to a registration”).

It is well established that for purposes of testing an opposer's asserted priority, the Board looks to the filing date of the opposed application. *1047406 Ont. Ltd. v. UVCleaning Sys.*, 2014 TTAB LEXIS 142, 11-12 (Trademark Trial & App. Bd. Apr. 14, 2014)(non-precedential opinion).⁸ Under Section 7(c) of the Trademark Act, 15 U.S.C. § 1057(c), Applicant is entitled to rely on the filing date of its application as its date of constructive use. *Id.*; *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542 (TTAB 1991); *1047406 Ont. Ltd. v. UVCleaning Sys.*, 2014 TTAB LEXIS 142, 11-12 (Trademark Trial & App. Bd. Apr. 14, 2014),

⁸ Copies of any cases not printed in the *United States Patent Quarterly* (USPQ) are attached hereto in Appendix B in alphabetical order.

To the extent that Opposer, as in the instant case, asserts prior use of their mark based on common law rights only, such priority must be proven by competent evidence because it is not established by a valid, subsisting registration. *1047406 Ont. Ltd. v. UVCleaning Sys.*, 2014 TTAB LEXIS 142, 11-12 (Trademark Trial & App. Bd. Apr. 14, 2014); *Research in Motion Limited v. Defining Presence Marketing Group Inc.*, 102 USPQ2d 1187, 1195 n. 23 (TTAB 2012); *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1960 (TTAB 2008) (The burden is on Opposer to prove its priority of use by a preponderance of the evidence). Statements made in pleadings cannot be considered as evidence on behalf of the party making them; such statements must be established by competent evidence during the time for taking testimony. *See Times Mirror Magazines, Inc. v. Sutcliff*, 205 USPQ 656, 662 (TTAB 1979); and TBMP §704.06(a). Likewise, statements in a brief have no evidentiary value. *See Electronic Data Systems Corp. v. EDSA Micro Corp.*, 23 USPQ2d 1460, 1462 n.5 (TTAB 1992); and TBMP §704.06(b).

Applicant filed its intent-to-use application for Buck Rogers on January 15, 2009. This filing date is made of record by the filing of the Notice of Opposition. 37 C.F.R. § 2.122(b)(1). An applicant is entitled to rely on the application's filing date for its priority date. *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542, 1544 (TTAB 1991)("[T]here can be no doubt but that the right to rely upon the constructive use date comes into existence with the filing of the intent-to-use application and that an intent-to-use applicant can rely upon this date in an opposition brought by a third party asserting common law rights"). Applicant does

not dispute that it has not alleged a date of first use earlier than this date, and accordingly, Applicant's priority date is January 15, 2009.

In the present case, Opposer's claim to priority is based on broad, unsupported allegations that "Opposer has used and continues to use the Buck Rogers mark in commerce." See Opposer's Brief at 4 – 5. The claim to priority relies upon: (1) prior registrations 0714184 and 1555871, which are not part of the record and are now canceled in any event; and (2) what Opposer describes as "its long-standing and continued use of the mark" as shown by the Geer Deposition Exhibits 6, 13, 14, 19, 34, 36, 37, 39, 40, 42, 43, 51, 53, 57. See Opposer's Brief at pg. 5. Both of these arguments fail for at least the reasons outlined herein.

1. Opposer's prior registrations are cancelled and may not be relied on to show priority of use

A cancelled registration is not evidence of any rights in the mark. *In re Grey Hosiery Mills*, 137 USPQ 455 (T.T.A.B. 1963); *General Precision, Inc. v. Thein*, 135 USPQ 478 (T.T.A.B. 1962) *aff'd*, 140 USPQ 610 (C.C.P.A. 1964). *See also* TBMP §704.03(b)(1)(A) ("Although an expired or cancelled registration may be made of record ... such a registration is not evidence of anything except that the registration issued; it is not evidence of any presently existing rights in the mark shown in the registration, or that the mark was ever used."). A party may not rely on a cancelled registration to show its priority of use. *See, e.g., Anderson, Clayton & Co. v. Krier*, 478 F.2d 1246, 1248, 178 USPQ 46 (C.C.P.A. 1973) ; *Starfield Group, Inc. v. Ergostar, Inc.*, 2009 TTAB LEXIS 414 (T.T.A.B. 2009) (not precedential) ("Any benefits conferred by the registration, including the evidentiary presumptions

afforded by Section 7(b) of the Trademark Act, were lost when the registration expired. ... As such, opposer may not rely upon its cancelled registration to support its claim of priority.").

On April 5, 2011, Opposer's prior registrations, Nos. 0714184 and 1555871, were cancelled on the grounds of fraud, for knowingly and intentionally providing false statements on declarations regarding Opposer's use of the mark in commerce, and abandonment. *See* Cancellation No. 92051659.⁹ Opposer even acknowledges the cancelled status of its prior registrations in Opposer's Brief. (Opposer's Brief at pg. 5). Thus, Opposer may not rely upon these cancelled registrations to support any claim of priority.

2. Opposer's evidence fails to show that Opposer has priority

In this case, Opposer is unable to establish priority of rights in any manner. Not only is the evidence entirely lacking, but it is indefinite, uncorroborated and unreliable.

a. Opposer cannot establish chain of title from any prior use

Without acknowledging the admissibility of Opposer's documents, a fair review of those documents makes it clear that Opposer did not commence use of the Mark in 1929, and, if it has rights, those rights would have to have been acquired through use of the Mark by a predecessor in interest. In fact, Ms. Geer's testimony indicates that Opposer acquired the trademark rights by assignment from John

⁹ In Cancellation No. 92051659, judgment was entered against the respondent pursuant to Trademark Rule 2.134(a), because the respondent applied to cancel its involved registrations under _ 7(e) without the written consent of every adverse party to the preceding. *See* Docket No. 20.

Dille. Geer Test. Dep, at 70:7 – 13. However, Opposer's brief is entirely devoid of any explanation of the chain of title to Opposer from 1929 to the present. Nor is there any explanation regarding the alleged assignment involving Robert Dille. See Geer Exhibit 33. The evidence submitted by Opposer is similarly sketchy as Opposer cannot establish that any actual trademark rights were assigned to Opposer. To the extent documents are submitted, even if they are admissible for any reason, they do not establish who the first user was in 1929, the extent or nature of use, or establish a clear chain of title to the present.

In summary, Opposer can only claim ownership to rights that were actually lawfully and properly transferred to Opposer. The record in this case is devoid of an unbroken chain of title showing the valid transfer of the Mark to Opposer. Accordingly, Opposer has failed to prove that it has ownership rights in the mark based on previous rights acquired by a predecessor in interest.

b. Opposer cannot establish priority through use in commerce

It is well established trademark law that a party acquires common law rights in a term solely by adopting and using the mark in connection with the goods or services rendered. *Chance v. Pac-Tel Teletrac Inc.*, 242 F.3d 1151, 58 USPQ2d 1222 (9th Cir. Cal. 2001) The Lanham Act defines use:

The term "use in commerce" means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. For purposes of this chapter, a mark shall be deemed to be in use in commerce-

- (1) on goods when – (A) it is place in any manner on the goods or their containers...

- (2) on services when it is used or displayed in the sale or advertising of services *and the services are rendered in commerce....*

15 U.S.C. § 1127 (emphasis added).

To demonstrate *bona fide* use of a trademark in commerce, one must show that the trademark is affixed to the goods in some way, either on the goods themselves, on the containers of the goods, affixed to the goods with tags, or other such ways. A service mark is different from a mark for goods, especially in the manner it is used in commerce. The legally significant use - giving rise to rights in a mark for goods is derived from the placing of the mark in some manner on the goods either directly or on their containers or packaging. A service mark, on the other hand, entails use in conjunction with the offering and providing of a service. See 15 U.S.C. § 1127.

Opposer's Notice of Opposition claims first use dating back to 1928. See Notice of Opposition, ¶15. Significantly, Opposer's Brief only vaguely cites to various exhibits and testimony from the Geer Deposition, but argues for a date of first use as early as 1929. See Opposer's Brief at 4. However, Opposer merely repeats the claim that "Opposer has been using the mark in commerce since as early as 1929", yet does not cite to any supporting evidence or explain how a single statement in a Notice of Opposition establishes continued or actual use of the BUCK ROGERS mark in commerce in 1929 let alone prior to January 15, 2009.

Summary of Opposer's Evidence in Support of its Claim of Priority

A Review of Opposer's evidence establishes that Opposer has failed to meet its burden of establishing when its alleged use of the Mark commenced.¹⁰

1. Geer Deposition. Other than broadly citing to the "Geer Deposition Exhibits 6, 13, 14, 19, 34, 36, 37, 39, 40, 42, 43, 51, 53 and 57", Opposer has not pointed to a single citation to the actual testimony of Ms. Geer. See Opposer's brief at 4 – 5. This has made responding to this deposition more difficult and time consuming for Applicant and for the Board as well. Essentially, Opposer makes it the Board's job to root out some support for its vague claims which is not its responsibility. See *Nationstar Mortg. LLC v. Mujahid Ahmad*, 112 USPQ2d 1361 350 (TTAB 2014) ("It is not [the Board's] burden to rummage through the record looking for the specific document(s) that applicant may have had in mind"). Nevertheless, a review of the Geer testimony makes it clear that Opposer has not established use of the mark dating back to 1929 let alone prior to January 15, 2009.¹¹ Opposer has provided no competent testimony from any witness with personal knowledge of the facts prior to January 15, 2009. Opposer's deponent, Ms.

¹⁰ Once again, Applicant sets forth its specific objections to the Geer Deposition and Geer Deposition in Applicant's Objections to the Evidence Presented by Opposer in Appendix A attached hereto.

¹¹ To the extent that Opposer seeks to provide pinpoint cites to the Geer deposition in its reply brief, Applicant objects and submits that any such citation should be disregarded as Applicant did not have the opportunity to respond. See also *Kohler Cp. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1104 (TTAB 2007) (objection raised at trial waived when petitioner waited until its reply to renew objections). It is axiomatic that rebuttal testimony may be used only to rebut evidence offered by the defendant. *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953 (TTAB 2008) (citing *Wet Seal Inc. v. FD Mgmt. Inc.*, 82 USPQ2d 1629 (TTAB 2007)).

Geer, for the most part, confined her testimony to authenticating documents. In addition, she did not become the Opposer's trustee until July 1, 2011. See Geer Test. Dep, at 4:7. A review of her testimony clearly establishes that she has no personal knowledge regarding Opposer's use prior to July 1, 2011 and her testimony is hearsay as it is based solely upon her review of documents.

2. Exhibit 6 shows the first two pages of what purports to be an agreement between Universal Pictures Company, Inc. and John F. Dille. The incomplete document does not establish any trademark use, and there is no evidence of record that the motion picture referred to in the agreement was ever produced and released in commerce. In fact the subject matter appears to be copyright in nature as there is no reference to the BUCK ROGERS trademark. Moreover, Opposer has not established any privity or chain of title regarding the subject matter of this agreement between it and John F, Dille. Finally, even if it were a complete license document, "[l]icensing is not by itself use of the mark." *GMC v. Aristide & Co.*, 87 USPQ2d 1179, 1185 (T.T.A.B 2008).

3. Exhibit 13 shows what purports to be an agreement with Leisure Concepts, Inc. and Universal Television. The incomplete, unsigned document does not establish any trademark use, and there is no evidence of record that the motion picture referred to in the agreement was ever produced and released into commerce. Again, the subject matter appears to be copyright in nature as there is no reference to the BUCK ROGERS trademark. Moreover, Opposer has not established any privity or chain of title regarding the subject matter of this agreement between it

and Leisure Concepts, Inc. Finally, even if it were a complete license document, “[l]icensing is not by itself use of the mark.” *GMC*, 87 USPQ2d at 1185.

4. Exhibit 14 shows what purports to be a memorandum of agreement between the Dille Family Trust and Walt Disney Pictures. The incomplete, unsigned document does not establish any trademark use, and there is no evidence of record that the motion picture referred to in the agreement was ever produced and released into commerce. Again, the subject matter of the agreement appears to be copyright in nature as there is no reference to the BUCK ROGERS trademark. Moreover, the first page contains conditions precedent and there is no evidence that those conditions were met or that there was ever a valid agreement. Finally, even if it were a complete license document, “[l]icensing is not by itself use of the mark.” *GMC*, 87 USPQ2d at 1185.

5. Exhibit 19 shows what purports to be an agreement between Herman and Geer Communications, Inc, and the Dille Family Trust. The incomplete, unsigned document does not establish any trademark use. Again, the subject matter appears to be copyright in nature as there is no reference to the BUCK ROGERS trademark. Finally, even if it were a complete license document, “[l]icensing is not by itself use of the mark.” *GMC*, 87 USPQ2d at 1185. Exhibit 19 also includes copies of the front and back covers and table of contents of various books with copyright dates of 2009-2013; however, Opposer has not provided any sufficient or competent evidence showing that these attachments to the license were actually sold in commerce prior to January 15, 2009. In particular, although Ms. Geer’s

testifies that the books were sold, she does not provide a date of first sale or use. See Geer Test. Dep at 31 – 37.

Moreover, neither Opposer nor Ms. Geer provide any corroborating evidence. Therefore, even if one or more of the books has a copyright notice for 2009, such a notice cannot establish use of the mark. *Smart Choice Food Sales, Ltd. v. Nature's Way Prods.*, 2006 TTAB LEXIS 123, 5-6 (Trademark Trial & App. Bd. Mar. 29, 2006) (abandonment found where the only documentation provided by respondent showing possible use of mark for a date prior to 2005 is a label with a 1994 copyright notice)(non-precedential opinion); *See also Clamage Industries Ltd. v. Glendinning Companies, Inc.*, 175 USPQ 362, 363 (TTAB 1972)(ownership of a copyright confers no trademark rights on the copyright owner.); *Penetred Corp. v. Uniroyal, Inc.*, 162 USPQ 620, 622 (TTAB 1969)(copyright registration is incompetent as evidence of use). Even if we could assume from these exhibits that there could have been use of the BUCK ROGERS mark on some goods, there is no information about the number of items bearing the mark that were made or sold. Thus, there is no basis to assume that, even if there was actual use, it was more than token use. *Westrex Corp. v. New Sensor Corp.*, 83 USPQ2d 1215, 1219 (TTAB 2007) ("[A] mere token sale or shipment of the goods does not constitute 'use' under the Trademark Act").

6. Geer Exhibits 34, 36, 37, 39, 40, 42, 43, 51 and 53 are various license agreements, a majority of which are incomplete and not fully unexecuted. The incomplete, unsigned documents do not establish any trademark use, and there is

no evidence of record that any of the products referred to in the agreement were ever produced and sold into commerce under the Mark prior to January 15, 2009. In fact, each of the exhibits was purportedly dated between 2010 – 2013, which is well after January 15, 2009. Again, “[l]icensing is not by itself use of the mark.” *GMC*, 87 USPQ2d at 1185. Opposer has again failed to provide any corroborative documentation regarding any transactions, sales, or royalty payments from these license agreements.

7. Geer Exhibit 57 consists of what purports to be copies of 2012 and 2014 issues of *Previews World*. On its face, this exhibit does not evidence any use of the BUCK ROGERS mark in commerce prior to Applicant’s application.

In some cases, proof of priority of use can be established by the testimony, of a single witness, if sufficiently probative, may suffice to prove priority. *Powermatics, Inc. v. Glebe Roofing Prods. Co.*, 341 F.2d 127, 144 USPQ 430 (CCPA 1965); See also *Nat’l Bank Book Co. v. Leather Crafted Prods., Inc.*, 218 USPQ 826, 828 (TTAB 1993)(oral testimony may be sufficient to prove the first use of a party's mark when it is based on personal knowledge, it is clear and convincing, and it has not been contradicted). Oral testimony of prior use is strengthened by documentary evidence of dates of use. *Elder Mfg. Co. v. International Shoe Co.*, 194 F.2d 114, 92 USPQ 330 (C.C.P.A.).

Overall, the Geer deposition testimony is characterized by contradictions, inconsistencies and indefiniteness, and cannot be relied upon as establishing prior use in commerce. *B.R. Baker Co. v. Lebow Bros.*, 150 F.2d 580, 66 USPQ 232, 236

(CCPA 1945). Ms. Geer did not become the trustee of Opposer until July 1, 2011. Geer Test. Dep. at 4:7. A review of her testimony clearly established that her knowledge regarding the events prior to January 15, 2009 is based on her review of documents and not her own personal knowledge. The testimony of a witness with no personal knowledge dating over two years after Applicant's priority claim, let alone dating back to 1929, is merely hearsay and insufficient to carry Opposer's burden. See, *Ariola-Eurodisc Gesellschaft v. Eurotone Intl., Ltd.*, 175 USPQ 250 (T.T.A.B. 1972).

In fact, Ms. Geer could not testify as to even one specific date of use prior to January 15, 2009. Therefore, her testimony does not establish prior use by a preponderance of the evidence. *Life Zone Inc.*, 87 USPQ2d at 1960 ("Without testimony or other evidence on this point, we cannot presume that opposer's use predates the filing date of the subject application, or indeed whether it even predates the filing of this opposition proceeding"). Manifestly, the lack of a specific citation from the Geer testimony in Opposer's Brief points to the fact that Geer was admittedly relied upon only, at most, to authenticate documents, and her testimony as to any actual use in commerce is not based on any personal knowledge. Such vague and imprecise testimony cannot carry Opposer's burden of proof regarding priority of use. See *NASDAQ Stock Market Inc. v. Antartica S.r.l.*, 69 USPQ2d 1718 (TTAB 1998).

Likewise, none of the documents relied upon by Opposer show any date of first use prior to January 15, 2009. The documents submitted as evidence fail to

establish that any goods or services were sold in commerce prior to Applicant's application. Moreover, Opposer has failed to provide any corroborating sales documentation regarding any transactions, sales, or royalty payments from any of the agreements relied upon. Therefore, Ms. Geer's vague testimony is not supported or corroborated by any documentation. *Nationstar Mortg. LLC v. Mujahid Ahmad*, 2014 TTAB LEXIS 350, 36-37 (Trademark Trial & App. Bd. Sept. 30, 2014)("In the case at hand, the documents on which applicant relies cannot be considered corroborative, for the testimony is so lacking in conviction and credibility as to be virtually incapable of corroboration. *Applicant does not so much seek to have the documents corroborate his testimony as to speak for him*")(emphasis added); *Elder Mfg. Co. v. International Shoe Co.*, 194 F.2d 114, 92 USPQ 330, 333 (C.C.P.A. 1952)("The testimony shows Hall, Hartwell & Co. carried on an extensive business and sold collars on a large scale. However, there is no evidence of any advertising or of sales of any product to any particular customers, nor is there any evidence which would indicate use of the trade mark "Mark Twain" on collars prior to October 1, 1921, except the oral testimony of the three witnesses aforementioned. The only specimen produced showing use of the mark was the above-mentioned collar which was manufactured in 1937").

To the extent Opposer is relying on licensing documents, as noted previously, licensing by itself does not establish use. In addition, the licenses provided by Opposer are either incomplete or key information had been redacted. Therefore,

even if the licenses are found to establish trademark rights of some kind, the record is silent as to any quality control provisions.

Thus, even if such licenses were competent evidence of use (which they are not), crucial to trademark licensing is quality control. If the trademark license does not contain quality control provisions, or if no quality control is exercised, the license may be considered a "naked license." See, e.g., *Barcamerica Int'l USA Trust v. Tyfield Imps., Inc.*, 289 F.3d 589, 62 USPQ2d 1673 (9th Cir. 2002); *Stanfield v. Osborne Indus., Inc.*, 52 F.3d 867 (10th Cir. 1995). If a trademark owner fails to exercise reasonable control over the use of a mark by a licensee, the trademark may cease to function as a symbol or quality and controlled source, leading to an involuntary loss of trademark rights. Therefore, since Opposer did not exercise quality control, the licenses it relies upon cannot be viewed as anything more than naked licenses. See, e.g., *CNA Financial Corp. v. Brownz*, 922 F. Supp. 567, 574 (M.D. Fla. 1996) (in this case the court found that a parent corporation that licensed its mark to a subsidiary without any quality control "lack[ed] the requisite control over the services connected with its marks and, therefore, forfeit[ed] its rights in the mark."); See also *Ritchie v. Williams*, 395 F.3d 283, 73 USPQ2d (6th Cir. 2005) (holding that the mark had been abandoned where there was no evidence of control over the licensee).

Opposer had ample opportunity to provide concrete evidence of its use of the Mark.¹² If Opposer had actually used the Mark continuously since 1929 and

¹² Significantly, the Geer Deposition was held in Ms. Geer's offices where she maintained Opposer's documents. Geer Test. Dep. at 72:10 – 12. She easily could

prior to January 15, 2009, it should have stacks of records with such evidence that substantiates its claims. However, the record is simply devoid of competent evidence showing use of the Mark by Opposer since 1929 or even before January 15, 2009.

Thus, Opposer's opposition should be dismissed as Opposer cannot establish priority by a preponderance of the evidence.

3. Opposer has abandoned any rights it may have had in the mark

To the extent that Opposer ever gained trademark rights in the subject mark, the rights were abandoned after 1972. *Money Store v. Harriscorp Finaance, Inc.*, 689 F.2d 666, 216 USPQ 11 (6th Cir. 1982) (holding that if an assignor abandoned prior to assignment, it is invalid: "An abandoned trademark is not capable of assignment."); *Golden Door, Inc. v. Odisho*, 646 F.2d 347, 208 USPQ 638 (9th Cir. 1980) (assignor did not use the mark for five years prior to assignment); *Pilates, Inc. v. Current Concepts, Inc.*, 120 F. Supp.2d 286 (S.D.N.Y. 2000)(1992 assignment was in gross and invalid where the "assignor" went out of business in 1989 and had no goodwill to assign).

Trademarks cannot be reserved or "horded" without trademark use or genuine intent to resume such use. *Imperial Tobacco, Ltd v. Philip Morris, Inc.*, 899 F.2d 1575, 1581, 14 USPQ2d 1390 (Fed. Cir. 1990) ("the Lanham Act was not intended to provide a warehouse for unused marks"); *Silverman v. CBS, Inc.*, 870

have provided additional corroborating documents if they were available. In fact, at one point the deposition was suspended to allow here to find and attempt to enter additional documents into evidence. Geer Test. Dep. at 72:10 – 73:1-5.

F.2d 40, 9 USPQ2d 1778 (2d Cir. 1989)(AMOS N ANDY abandoned for TV Show characters); *Exxon Corp. v. Humble Exploration Co.*, 695 F.2d 96, 217 USPQ 1200 (5th Cir. 1985) ("limited arranged sales of [trademarked] products as part of Exxon's trademark maintenance program are insufficient uses to avoid prima facie abandonment under 15 U.S.C. § 1127;" following discontinued use of the mark, party must have plans to resume bona fide commercial use of the marks to avoid abandonment).

Abandonment of a mark occurs when the mark ceases being used for the goods or services with which it is associated with intent not to resume use. 15 U.S.C. § 1127. Intent not to resume may be inferred from the circumstances. *Id.* Additionally, a rebuttable presumption of abandonment arises after three consecutive years of non-use. *Id.* The statutory presumption of abandonment applies "to a party's unregistered common-law mark." *Miller Brewing Company v. Oland's Breweries [1971] Limited*, 548 F.2d 349, 192 USPQ 266, 267 (CCPA 1976).

As discussed above, "[l]icensing is not by itself use of the mark." *GMC*, 87 USPQ2d at 1185. If licensing is not by itself use of the mark, certainly assignments and option contracts fail to evidence use as well. Even assuming, *arguendo*, that Opposer's exhibits purporting to show assignments and agreements between a purported owner of the mark and third-parties evidence use of the mark, the record is facially clear that there are long periods of unexplained non-use.

For example, Opposer offers a 1977-1978 option contract to "acquire exclusive world-wide live motion picture and television rights in and to the copyrighted

character “BUCK ROGERS” and the related characters, formats, designs, stories, and other materials previously exploited in published works” to show continued use of the mark. See Geer Exhibit 13. However, Opposer fails to provide evidence regarding whether this option was ever exercised, or whether the BUCK ROGERS mark was actually used.

The next chronological piece of evidence offered to show continued use is yet another option contract to acquire all rights “in and to the comic book character ‘BUCK ROGERS.’” Geer Exhibit 14. This option contract is dated October 31, 1996, nearly nineteen (19) years after the preceding option contract of record.

A majority of Opposer’s other alleged evidence of alleged use consists of multiple licenses with dates ranging from 2008-2013. Geer Exhibits 19, 33, 34, 36, 37, 39, 40, 42, 43, 50, 51, 53. None of these licenses include attachments evidencing use by any licensee prior to Applicant’s priority date. It is clear from the record that even if, *arguendo*, some of Opposer’s evidence showed use, Opposer, has abandoned the mark for numerous periods of more than three (3) years. For at least these reasons, Opposer’s opposition should be dismissed.

D. Applicant Had A Bona Fide Intent To Use the Mark

Opposer, for the first time, now argues that Applicant lacked a *bona fide* intent to use the mark BUCK ROGERS at the time Applicant filed its application is not properly before the Board. See Opposer’s Brief at 11. This is the first time that Opposer has alleged this claim as it is not asserted in its Notice of Opposition nor was it raised elsewhere. Applicant objects to the late introduction of this claim,

which was not previously pled, for which no amended pleading was requested, and to which Applicant did not have the opportunity to submit evidence.

The rules of the TTAB make it clear that “[a] plaintiff may not rely on an unpleaded claim.” See TBMP § 314. Accordingly, the Board must give no consideration to Opposer’s claim. *Kohler Co.*, 82 USPQ2d 1106 n. 3 (TTAB 2007).¹³

E. Opposer has failed to establish a likelihood of confusion for most of the goods and services in Applicant’s application.

Applicant agrees that *In re E.I. DuPont de Nemours & Co.*, 177 USPQ 563 (C.C.P.A. 1973) controls the evaluation of likelihood of confusion. In *DuPont*, the court stated that the following factors, when of record, must be considered:

1. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression;
2. The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use;
3. The conditions under which and buyers to whom sales are made, i.e., “impulse” vs. careful, sophisticated purchasing;
4. The fame of the prior mark (sales, advertising, length of use);
5. The number and nature of similar marks in use on similar goods;

¹³ Applicant maintains its objection and believes that the Board cannot consider Opposer’s claim. However, if the Board does consider the claim, Applicant notes that as an initial matter, Opposer has failed to even meet its initial burden of demonstrating by a preponderance of the evidence that applicant lacked a *bona fide* intent to use the mark on the identified goods. *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1587 (TTAB 2008).

6. The nature and extent of any actual confusion and the length of time during and conditions under which there has been concurrent use without evidence of actual confusion;
7. The variety of goods on which a mark is or is not used (house mark, “family” mark, product mark);
8. The market interface between applicant and the owner of a prior mark;
9. The extent to which applicant has a right to exclude others from use of its mark on its goods;
10. The extent of potential confusion, i.e. whether *de minimis* or substantial;
11. Any other established fact probative of the effect of use.

In the instant case, Opposer has failed to establish a likelihood of confusion between the goods and services found in the opposed application and the goods and services for which Opposer claims use in its Notice of Opposition, i.e., “comic books, action figures, feature films, picture frames, belt buckles, key chains, resin statues, artwork, t-shirts, board games, computer software, internet television show license, DVDs, Blu-Ray video discs, and radio programs.” See Opposer’s Notice of Opposition, ¶ 12.

1. The Similarity of the Marks

Applicant does not dispute that both parties are claiming rights in BUCK ROGERS and that the marks are identical.

2. Similarity of The Goods

Applicant objects to Opposer’s characterization that the parties’ goods and

services are essentially identical. See Opposer's Brief at 6 – 7. Opposer supports that claim by relying upon goods and services from Opposer's prior cancelled registrations and Opposer's pending applications. However, as noted previously, neither the prior cancelled registrations nor Opposer's pending applications are at issue in this case and have not been properly entered into evidence. All that would be in issue here would be Opposer's rights based on common law use of the mark, and the appurtenant goods or services.

Therefore, the Board must ignore Opposer's reliance on any applications or canceled registrations that are not entered into evidence, and must only compare Applicant's goods and services from the opposed application to the goods and services for which use is claimed in the Notice of Opposition, i.e., "comic books, action figures, feature films, picture frames, belt buckles, key chains, resin statues, artwork, t-shirts, board games, computer software, internet television show license, DVDs, Blu-Ray video discs, and radio programs." See Opposer's Notice of Opposition, ¶ 12. To the extent there is overlap among the goods and services and they are identical, likelihood of confusion could apply if Opposer could establish common law rights and priority of use of the mark for those goods and services.

However, there can be no overlap for the remaining of Applicant's goods and services reproduced below:

International Class 009: Telephone and radio pagers; short motion picture films about science fiction, fantasy heroism and action adventure and adventure; video cassette recorders and players, compact disc players, digital audio recorders and players; radios; mouse pads; eyeglasses, sunglasses and cases therefore; game equipment, namely, video game machines for use with televisions,

hand-held electronic games adapted for use with television receivers only and player operated electronic controllers for electronic video game machines; video and computer game programs; video game cartridges and cassettes; cellular telephone accessories, namely, cell phone covers, batteries, fitted plastic films known as skins for covering and providing a scratch proof barrier, decorative charms, decorative ornaments, headsets, boosters, connectivity kits and memory cards; encoded magnetic cards

International Class 016: Stationery, writing paper, envelopes, notebooks, diaries, note cards, greeting cards, trading cards; lithographs; pens, pencils, cases therefor, erasers, crayons, markers, colored pencils, painting sets for children, chalk and chalkboards; decals, heat transfers; posters; mounted and unmounted photographs; book covers, book marks, calendars, gift wrapping paper; Paper party decorations; Printed patterns for costumes, pajamas, sweatshirts and t-shirts; paper party favors

International Class 025: Clothing, namely, pajamas, shirts, jumpers, sweatshirts, vests, coats, jackets, overcoats, trousers, shorts, socks, gloves, ties, scarves, skirts, underwear, footwear; headgear, namely, hats, caps, head scarves, baseball caps and headbands, clothing accessories, namely, belts, gloves, suspenders, sweat bands, straps for bras

International Class 028: Toys, namely, musical toys, inflatable toys, electric action toys, punch toys, plush toys, talking toys, toy cars, role-playing toys in the nature of play sets for children to imitate real life occupations, toy boats, toy airplanes, toy weapons, toy rocket ships, construction toys, toy putty, toy scooters, toy action figures and accessories for use with toy action figures, toy model vehicles, water squirting toys and toy model space craft, toy building blocks, toy model hobby craft kits comprising paints, beads, ceramics, plastics, crayons, stencils, toy model vehicles and related accessories sold as a units, toy modeling dough kits comprising toy modeling dough, molds and accessories for use therewith sold as units, toy vehicles, toy weapons, toy model vehicles and accessories therefor sold as a unit, wind-up toys and miniature toy helmets; sporting goods, namely, beach balls, playground balls, soccer balls, sport balls, baseball balls, basketball balls, baseball bats, and baseball gloves; games, namely, action type target games, card games, hand held units for playing electronic games other than those adapted for use with an external display screen or monitor, virtual arcade shooting game machines, trading card games, parlor games, action skill games, coin operated and non-coin operated pinball machine games, stand alone video game machines, collectible card games, and collectible miniature board games

International Class 041: Entertainment services, namely, an on-going series

provided through broadcast mediums, namely, television, webcasts, and radio broadcasts

For these goods, Opposer has not presented any evidence, and therefore, cannot carry its burden.

3. Channels of Trade

Opposer again has assumed that all of the goods and services in its cancelled registration and pending applications should be used to establish the similarity of channels of trade. As noted above in Section 2 above, to the extent there is overlap among the goods and services actually at issue in the opposition, Applicant conceded a similarity in the channels of trade.

With respect to the remaining goods and services, Opposer has not presented any evidence, and therefore, cannot carry its burden.

4. Lack of Consumer Sophistication

Applicant agrees with Opposer that this factor has no application in this opposition and is moot. See Opposer's Brief at 8.

5. The Fame of The Prior Mark

Opposer asserts that it has submitted substantial evidence attesting to the efforts Opposer has made in the marketplace. As noted in Section V. C. 2. at 20, Opposer has failed to establish any use of the mark and any possible use postdates Applicant's priority date. Moreover, even if Opposer establishes priority, the promotions referred to only apply to Opposer's the goods and services at issue and do not extend to Applicant's other goods and services.

6. Similar Marks in Use on Similar Goods

Opposer relies upon another of its applied for trademark applications to establish this factor. See Opposer's Brief at 8 – 9. However, once again that application has not been made of record in this proceeding and should not be considered by the Board. Accordingly, this factor favors neither party.

7. Actual Confusion

Applicant agrees with Opposer that this factor does not apply in this case because Applicant's rights are based on intent-to-use. See Opposer's Brief at 9.

8. Parties Use Mark on Variety of Goods

Opposer claims that this factor favors it because it uses the Mark on a variety of goods. As noted above, there is no evidence of such use. Even if there was such use established, the use would only be for a discrete set of goods. See Opposer's Brief at 9.

9. Market Interface

Opposer has not presented any evidence of the market interface, and therefore, cannot carry its burden.

Rather than address the market interface, Opposer apparently assumes that Applicant is claiming market interface based on Phillip Nowlan being the author and creator of BUCK ROGERS, and Opposer claims that this claim would be negated by Geer Exhibit 8 which purports to be an assignment between Theresa Marie Nowlan and John F. Dille, among others. Applicant submits that this circular argument fails because Applicant is not asserting rights based on it being

the creator and owner of Buck Rogers. Moreover, the document itself is of no evidentiary value because Opposer has failed to establish the authenticity of the document, that it is a valid assignment and that there is any privity or chain of title between the parties identified in the document and Opposer and Applicant.

For these reason, this factor favors neither party.

10. Right to Exclude Others

Applicant submits that this factor favors Applicant because Opposer has established common law rights in the Mark and Applicant has not. Opposer Brief at 10. As noted above, Opposer has not established any such use. Moreover, Applicant has rights by virtue of its intent-to-use application. As such, this factor is not relevant to this case and this factor favors neither party.

11. Extent of Potential Confusion

Other than making conclusory statements, Applicant has not established the extent of any potential consumer confusion. Accordingly this factor favors Applicant.

12. Opposer Has Failed to Meet its Burden.

A review of the foregoing factors makes it clear that even if Opposer prevails on its priority claim, it at most, may only establish has establish a likelihood of confusion with respect to: “comic books, action figures, feature films, picture frames, belt buckles, key chains, resin statues, artwork, t-shirts, board games, computer software, internet television show license, DVDs, Blu-Ray video discs, and radio programs.” Opposer has failed to present evidence establishing likelihood of

confusion with any of Applicant's remaining goods and services which are set forth below,

International Class 009: Telephone and radio pagers; short motion picture films about science fiction, fantasy heroism and action adventure and adventure; video cassette recorders and players, compact disc players, digital audio recorders and players; radios; mouse pads; eyeglasses, sunglasses and cases therefore; game equipment, namely, video game machines for use with televisions, hand-held electronic games adapted for use with television receivers only and player operated electronic controllers for electronic video game machines; video and computer game programs; video game cartridges and cassettes; cellular telephone accessories, namely, cell phone covers, batteries, fitted plastic films known as skins for covering and providing a scratch proof barrier, decorative charms, decorative ornaments, headsets, boosters, connectivity kits and memory cards; encoded magnetic cards

International Class 016: Stationery, writing paper, envelopes, notebooks, diaries, note cards, greeting cards, trading cards; lithographs; pens, pencils, cases therefor, erasers, crayons, markers, colored pencils, painting sets for children, chalk and chalkboards; decals, heat transfers; posters; mounted and unmounted photographs; book covers, book marks, calendars, gift wrapping paper; Paper party decorations; Printed patterns for costumes, pajamas, sweatshirts and t-shirts; paper party favors

International Class 025: Clothing, namely, pajamas, shirts, jumpers, sweatshirts, vests, coats, jackets, overcoats, trousers, shorts, socks, gloves, ties, scarves, skirts, underwear, footwear; headgear, namely, hats, caps, head scarves, baseball caps and headbands, clothing accessories, namely, belts, gloves, suspenders, sweat bands, straps for bras

International Class 028: Toys, namely, musical toys, inflatable toys, electric action toys, punch toys, plush toys, talking toys, toy cars, role-playing toys in the nature of play sets for children to imitate real life occupations, toy boats, toy airplanes, toy weapons, toy rocket ships, construction toys, toy putty, toy scooters, toy action figures and accessories for use with toy action figures, toy model vehicles, water squirting toys and toy model space craft, toy building blocks, toy model hobby craft kits comprising paints, beads, ceramics, plastics, crayons, stencils, toy model vehicles and related accessories sold as a units, toy modeling dough kits comprising toy modeling dough, molds and accessories for use therewith sold as units, toy vehicles, toy weapons, toy model vehicles and accessories therefor sold as a unit, wind-up toys

and miniature toy helmets; sporting goods, namely, beach balls, playground balls, soccer balls, sport balls, baseball balls, basketball balls, baseball bats, and baseball gloves; games, namely, action type target games, card games, hand held units for playing electronic games other than those adapted for use with an external display screen or monitor, virtual arcade shooting game machines, trading card games, parlor games, action skill games, coin operated and non-coin operated pinball machine games, stand alone video game machines, collectible card games, and collectible miniature board games

International Class 041: Entertainment services, namely, an on-going series provided through broadcast mediums, namely, television, webcasts, and radio broadcasts

Again, it is not for the Board to construct arguments or evidence on behalf of the Opposer; Opposer has left virtually every blank for the Board to fill in. For these reasons, even if priority is established by Opposer, judgment should be entered in Applicant's favor with respect to the remaining goods and services.

VI. CONCLUSION

For the foregoing reasons Applicant, respectfully submits that the Opposition should be dismissed and judgment enter in favor of Applicant

Respectfully submitted,

NOWLAN FAMILY TRUST

Date: March 30, 2015

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Trademark Opposition of:

Mark: BUCK ROGERS
Serial No.: 77/650,082
Filed: July 12, 2011

Opposition No. 91200643

Dille Family Trust,
Opposer

v.

Nowlan Family Trust,
Applicant

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of Applicant, Nowlan Family Trust's Final Brief on the Merits was served on Applicant's Attorney of Record by first-class mail, postage pre-paid, to the following:

Vincent G. LoTempio, Esq.
Kloss, Stenger & LoTempio
69 Delaware Avenue, Suite 1002
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Date: March 30, 2015

By: s/John J. O'Malley
John J. O'Malley, Esquire

Appendix A – Evidentiary Objections

Pursuant to 37 C.F.R. § 2.123(k) and TBMP § 707.03(c), Applicant makes and reiterates the following evidentiary objections.¹

1. Applicant objects to Opposer’s October 8, 2014 Revised Notice of Reliance² on the following grounds:

- a. Opposer’s item 1 purports to be a summary from the USPTO.gov website for Opposer’s Application Serial No. 77/831,213 for the mark “Buck Rogers.” Opposer claims that the document is relevant because the dates of use contained in the document indicate Opposer’s dates of first use. Applicant objects that the submission of a TARR status page is not the proper way to enter Opposer’s

¹ By way of background, during the Geer Deposition the parties agreed that Applicant’s objections based on hearsay, foundations and the document speaking for itself were continuing throughout the deposition. See Geer Test. Dep. at 18:3 – 13; and 74:18 – 20.

² Opposer filed its first Notice of Reliance on March 26, 2014. However, the following documents were stricken from the Notice of Reliance pursuant to the Board’s October 3, 2014 Order and Opposer was instructed file a revised Notice of Reliance: Documents appointing Louise A. Geer as trustee of the Dille Family Trust; Filed Application for Certificate of Authority for Dille Family Trust with Pennsylvania Department of State; Executed Release, of rights to relating to the Buck Rogers mark from Theresa Maria Nowlan to John F. Dille et al., dated May 14, 1942; and two-checks – one drafted for \$1,750.00 and the other drafted for \$7,000.00; Partially redacted license between Dille Family Trust and Anvos Productions, LLC dated 8/9/11; Partially redacted license between Dille Family Trust and B. Rood Illustrations, dated 5/01/11; Partially redacted license between Dille Family Trust and Creations Fantastic, Inc., dated 8/6/10; Partially redacted license between Dille Family Trust and Drizzle Studios, dated 9/14/10; Partially redacted agreement between Dille Family Trust and Hermes Press, dated 3/16/08; Partially redacted license between Dille Family Trust and Intrada, Inc., dated 9/01/11; and Partially redacted license between Dille Family Trust and Silk Pearce, dated 9/02/11.

application into evidence and because the document constitutes hearsay in violation of F.R.E. 802 and there is no applicable exception. Applicant objects under 37 CFR § 2.122(b)(2), because “[t]he allegation in an application for registration,..., a date of use is not evidence on behalf of the applicant or registrant; a date of use of a mark must be established by competent evidence,” and Opposer has not introduced any competent evidence. Applicant further objects to these documents on the following grounds:

- b. Opposer’s item 2 purports to be a summary from the USPTO.gov website for Opposer’s Application Serial No. 77/831,393 for the mark “Buck Rogers.” Opposer claims that the document is relevant because the dates of use contained in the document indicate Opposer’s dates of first use. Applicant objects that the submission of a TARR status page is not the proper way to enter Opposer’s application into evidence and because the document constitutes hearsay in violation of F.R.E. 802 and there is no applicable exception. Applicant objects under 37 CFR § 2.122(b)(2), because “[t]he allegation in an application for registration,..., a date of use is not evidence on behalf of the applicant or registrant; a date of use of a mark must be established by competent evidence,” and Opposer has not introduced any competent evidence. Applicant further objects to these documents on the following grounds:

c. Opposer's item 3 purports to be a copy of pages from Previews 2012 edition. Applicant objects on the grounds that the documents are not relevant to priority or likelihood of confusion since they are dated after January 15, 2009. Opposer also because the document constitutes hearsay in violation of F.R.E. 802 and there is no applicable exception.

2. Applicant objects to the testimony of Ms. Louise Geer, Opposer's sole deponent. Opposer did not cite a single page of testimony from Ms. Geer and simply referred to her testimony as a whole. Opposer objects to the testimony on that basis as it unfairly requires Applicant to guess and assume the testimony that Applicant is relying upon which is prejudicial to Applicant. Applicant further objects to the testimony on the basis that it violates F.R.E. 602 in that Ms. Geer's testimony regarding use and events prior to January 15, 2009 is based on her review of documents and that she lacks any personal knowledge regarding facts prior to her becoming trustee for Opposer on July 1, 2011, including Opposer's use prior. See Geer Test. Dep. at 4:7. Moreover, the overwhelming majority of Ms. Geer's testimony constitutes hearsay pursuant to F.R.E. 802 because it is based on documents created prior to her becoming trustee on July 1, 2011, and there is no applicable exception. As noted, it is burdensome to cite specific examples because Opposer has not cited any specific testimony by Geer. Nevertheless, instances of hearsay testimony in violation of F.R.E. 802, with no applicable exception, are found at the following locations: Geer Test. Dep. at 5:14-6:19; 7:1-7; 11:5-9; 11:18-20; 12:6-

10; 12:13-16; 12:18-19; 21:11-21; 22:1-8; 22:18-22; 23:2-19; 23:24-24:2; 24:16-26:22; 27:8-14; 28:13-23; 29:22-25; 30:10-15; 31:2-8; 31:18-32:12; 32:16-25; 34:11-16; 36:9-19; 37:19-23; 38:4-39:4; 39:18-22; 40:21-41:8; 41:13-20; 41:24-42:3; 42:19-43:13; 43:24-44:7; 44:17-45:5; 45:8-14; 45:24-46:4; 48:23-49:1; 49:9-16; 50:6-19; 51:16-21; 53:2-8; 53:18-54:11; 55:7-17; 57:16-19; 58:22-25; 59:10-25; 60:14-61:16; 62:18-25; 73:7-25.

3. **Exhibits 1 – 5:** These exhibits consist of documents dated between 1928 and 1937 which purport to be agreements between Phillip F. Nowlan and National Newspaper Services. Although these documents were not cited in Opposer’s Brief, Applicant objects to these documents on the grounds of relevance. Applicant further objects to these documents on the following grounds:

- a. The documents lack the authentication that F.R.E. 901(a) requires.
- b. The deponent, Ms. Geer, lacks personal knowledge to verify the information contained in the documents as required by F.R.E. 602 because she did not become the Opposer’s trustee until July 1, 2011, the documents are dated between 1928 to 1937, and she does not have personal knowledge of the facts.
- c. The document violates the original document (best evidence rule) of F.R.E. 1002.
- d. To the extent that Opposer is using the document to assume facts not in evidence, i.e., (i) that there is privity between and among the parties; (ii) that National Newspaper Services is a predecessor in

interest to Opposer; (iii) that valid agreements were executed. Such facts have not been established by competent evidence.

- e. The documents constitute hearsay in violation of F.R.E. 802 and there is no applicable exception. The document may not be accepted for establishing the truth of the matters therein.

4. **Exhibit 6:** This document purports to show the first two pages of what purports to be an agreement between Universal Pictures Company, Inc. and John F. Dille. Applicant objects to this document on the grounds that it is an incomplete document and it is impossible to ascertain if it is a valid agreement and it is not relevant to the subject matter of the opposition. Applicant further objects to these documents on the following grounds:

- a. The documents lack the authentication that F.R.E. 901(a) requires.
- b. The deponent, Ms. Geer, lacks personal knowledge to verify the information contained in the documents as required by F.R.E. 602 because she did not become the Opposer's trustee until July 1, 2011, the document is dated 1938, and she does not have personal knowledge of the facts.
- c. The document violates the original document (best evidence rule) of F.R.E. 1002.
- d. To the extent that Opposer is using the document to assume facts not in evidence, i.e., (i) that there is privity between and among the parties; (ii) that John F. Dille is a predecessor in interest to

Opposer; (iii) that a valid license agreement was executed; (iv) that use of the mark resulted from this purported licenses agreement and that any goodwill associated with such use inured to the benefit of Opposer. Such facts have not been established by competent evidence.

- e. The document constitutes hearsay in violation of F.R.E. 802 and there is no applicable exception. The document may not be accepted for establishing the truth of the matters therein.

5. **Exhibit 7:** This document purports to show the first page of a complaint between Theresa Marie Nowlan, executrix of the will of Philip Francis Nowlan and National Newspaper Service, John F. Dille, John F. Dille Co., Richard Calkins and Buck Rogers Company. Applicant objects to this document on the grounds of relevance, and that it is an incomplete document and it is impossible to ascertain what the subject matter of the document and it is not relevant to the subject matter of the opposition. Applicant further objects to the documents on the following grounds:

- a. The documents lack the authentication that F.R.E. 901(a) requires.
- b. The deponent, Ms. Geer, lacks personal knowledge to verify the information contained in the documents as required by F.R.E. 602 because she did not become the Opposer's trustee until July 1, 2011 and she does not have personal knowledge of the facts..

- c. To the extent that Opposer is using the document to assume facts, not in evidence, i.e., (i) that there is privity between and among the parties; (ii) that National Newspaper Service, John F. Dille, John F. Dille Co., Richard Calkins or Buck Rogers Company are predecessors in interest to Opposer; (iii) that that Applicant is the successor the Estate of Philip F. Nowlan. Such facts have not been established by competent evidence.
- d. The document violates the original document (best evidence rule) of F.R.E. 1002.
- e. The document constitutes hearsay in violation of F.R.E. 802 and there is no applicable exception. The document may not be accepted for establishing the truth of the matters therein.

6. **Exhibit 8:** This document purports to be a litigation-related document between Theresa Marie Nowlan, executrix of the will of Philip Francis Nowlan and National Newspaper Service, John F. Dille, John F. Dille Co., Richard Calkins and Buck Rogers Company. Applicant objects to this document on the grounds that it is not relevant to the issues of standing and likelihood of confusion as asserted by Opposer at Opposer's Brief at 4 and 9. Applicant further objects to these documents on the following grounds:

- a. The documents lack the authentication that F.R.E. 901(a) requires.
- b. The deponent, Ms. Geer, lacks personal knowledge to verify the information contained in the documents as required by F.R.E. 602

because she did not become the Opposer's trustee until July 1, 2011, this document purports to be dated in 1942, and she does not have personal knowledge of the facts.

- c. The document violates the original document (best evidence rule) of F.R.E. 1002.
- d. To the extent that Opposer is using the document to assume facts, not in evidence, i.e., (i) that there is privity between and among the parties; (ii) that National Newspaper Service, John F. Dille, John F. Dille Co., Richard Calkins or Buck Rogers Company are predecessors in interest to Opposer; (iii) that that Applicant is the successor the Estate of Philip F. Nowlan; (iv) that a valid agreement was executed. Such facts have not been established by competent evidence.
- e. The document constitutes hearsay in violation of F.R.E. 802 and there is no applicable exception. The document may not be accepted for establishing the truth of the matters therein.

7. **Exhibit 13:** This document purports to be an agreement between Leisure Concepts, Inc. and Universal Television dated 1978. Applicant objects to this document on the grounds that it is an incomplete document and it is impossible to ascertain what the subject matter of the document and it is not relevant to the subject matter of the opposition

- a. The documents lack the authentication that F.R.E. 901(a) requires.

- b. The deponent, Ms. Geer, lacks personal knowledge to verify the information contained in the documents as required by F.R.E. 602 because she did not become the Opposer's trustee until July 1, 2011, the agreement is dated in 1978, and she does not have personal knowledge of the facts.
- c. The document violates the original document (best evidence rule) of F.R.E. 1002.
- d. To the extent that Opposer is using the document to assume facts, not in evidence, i.e., (i) that there is privity or a chain of title between and among Leisure Concepts, Inc and Opposer; (ii) that a valid license agreement was executed; (iii) that use of the mark resulted from this purported license agreement and that any goodwill associated with such use inured to the benefit of Opposer. Such facts have not been established by competent evidence.
- e. The document is not relevant because on its face it does not even establish that it involves the licensing of a trademark.
- f. The document constitutes hearsay in violation of F.R.E. 802 and there is no applicable exception. The document may not be accepted for establishing the truth of the matters therein.

8. **Exhibit 14:** This document purports to show a memorandum of agreement between the Dille Family Trust and Walt Disney Pictures with a 1996 date. Applicant objects to this document on the grounds that it is an incomplete

document and it is impossible to ascertain what the subject matter of the document and it is not relevant to the subject matter of the opposition

- a. The documents lack the authentication that F.R.E. 901(a) requires.
- b. The deponent, Ms. Geer, lacks personal knowledge to verify the information contained in the documents as required by F.R.E. 602 because she did not become the Opposer's trustee until July 1, 2011, the document is dated 1996, and she does not have personal knowledge of the facts.
- c. The document violates the original document (best evidence rule) of F.R.E. 1002.
- d. To the extent that Opposer is using the document to assume facts, not in evidence, i.e., (i) that a valid license agreement was executed and that the that the conditions precedent set forth in the agreement were met; and (ii) that use of the mark resulted from this purported licenses agreement and that any goodwill associated with such use inured to the benefit of Opposer. Such facts have not been established by competent evidence.
- e. The document is not relevant because on its face it does not even establish that it involves the licensing of a trademark.
- f. The document constitutes hearsay in violation of F.R.E. 802 and there is no applicable exception. The document may not be accepted for establishing the truth of the matters therein.

9. **Exhibit 19:** This exhibit purports to be an agreement between Hermes and Geer Communications, Inc, and the Dille Family Trust, and also includes copies of the front and back covers and table of contents of various books with copyright dates of 2009-2013. Applicant objects to this document on the grounds that the documents are incomplete documents and in the case of the purported agreement it is impossible to ascertain if it is a valid agreement. Applicant further objects to these documents on the following grounds:

- a. The documents lack the authentication that F.R.E. 901(a) requires.
- b. The one page agreement document violates the original document (best evidence rule) of F.R.E. 1002.
- c. To the extent that Opposer is using the document to assume facts, not in evidence, i.e., (i) that a valid license agreement was executed; (ii) that use of the mark resulted from this purported license agreement and that any goodwill associated with such use inured to the benefit of Opposer. Such facts have not been established by competent evidence.
- d. The document is not relevant because the books do not actually establish a date of first use or a date that any book was actually published or sold in commerce prior to January 15, 2009.
- e. The document constitutes hearsay in violation of F.R.E. 802 and there is no applicable exception. The document may not be accepted for establishing the truth of the matters therein.

10. **Exhibit 31:** This document purports to be a printout from the Canadian Intellectual Property Office. Although these documents were not cited in Opposer's Brief Applicant, Opposer objects to these documents on the grounds of relevance as foreign registration documents have no bearing on an opposition at the TTAB. Foreign use of a mark creates no rights in such mark in the United States, and any information or evidence pertaining to foreign use is not relevant to a party's right to register the mark in the United States. *Double J of Broward Inc. v. Skalonly Sportswear GmbH*, 21 U.S.P.Q.2d 1609, 1612 (T.T.A.B. 1992); *Johnson & Johnson v. Salve S.A.*, 183 U.S.P.Q. 375, 376 (T.T.A.B. 1974). Applicant further objects to these documents on the following grounds:

- a. The documents lack the authentication that F.R.E. 901(a) requires.
- b. The deponent, Ms. Geer, lacks personal knowledge to verify the information contained in the documents as required by F.R.E. 602 because she did not become the Opposer's trustee until July 1, 2011 and she does not have personal knowledge of the facts.
- c. The document constitutes hearsay in violation of F.R.E. 802 and there is no applicable exception. The document may not be accepted for establishing the truth of the matters therein.

11. **Exhibit 33:** This exhibit consists of a series of documents that purport to be documents relating to the appointment of Louise Geer as trustee and four (4) documents that purport to be trademark assignments. Applicant further objects to these documents on the following grounds:

- a. The documents lack the authentication that F.R.E. 901(a) requires.
- b. The deponent, Ms. Geer, lacks personal knowledge to verify the information contained in the attached assignment documents as required by F.R.E. 602 because she did not become the Opposer's trustee until July 1, 2011, the assignment documents are dated between 1968 and 1982, and she does not have personal knowledge of the facts.
- c. The four (4) assignment documents violate the original document (best evidence rule) of F.R.E. 1002.
- d. To the extent that Opposer is using the document to assume facts, not in evidence, i.e., (i) that there is privity and chain of title between and among the parties, namely, Robert C. Dille and Opposer; (ii) that actual valid and subsisting trademark rights were transferred by the assignment. Such facts have not been established by competent evidence.
- e. The document is not relevant because although the document purports to transfer various trademarks and trademark registrations the actual trademark registrations are not identified and were not entered into evidence in the opposition.
- f. The document constitutes hearsay in violation of F.R.E. 802 and there is no applicable exception. The document may not be accepted for establishing the truth of the matters therein.

12. **Exhibits 34, 36, 37, 39, 40, 42, 43, 51 and 53:** Applicant objects to these exhibits on the grounds that the documents are either incomplete documents or contain redactions and in the case of the purported agreements it is impossible to ascertain if the agreements are valid. Applicant further objects to these documents on the following grounds:

- a. The documents lack the authentication that F.R.E. 901(a) requires.
- b. The document violates the original document (best evidence rule) of F.R.E. 1002.
- c. To the extent any of the documents are dated before Ms. Geer became trustee on January 1, 2011, Ms. Geer lacks personal knowledge as required by F.R.E. 602 because to verify the information contained in those documents.
- d. To the extent that Opposer is using the document to assume facts not in evidence, i.e., (i) that valid license agreement were executed; (ii) that use of the mark resulted from this purported license agreements and that any goodwill associated with such use inured to the benefit of Opposer. Such facts have not been established by competent evidence.
- e. The documents are not relevant because they are all dated prior after January 15, 2009.

- f. The document constitutes hearsay in violation of F.R.E. 802 and there is no applicable exception. The document may not be accepted for establishing the truth of the matters therein.

13. **Exhibit 50:** This document purports to be a copy of an advertising product dated 2013. Although the document was not cited in Opposer's Brief, Applicant objects to this document on the grounds of relevance as by Ms. Geer's own testimony the document was for advertising purposes with a date of 2013. Applicant further objects to these documents on the following grounds:

- a. The document constitutes hearsay in violation of F.R.E. 802 and there is no applicable exception. The document may not be accepted for establishing the truth of the matters therein.

14. **Exhibit 57:** These documents purport to consist of copies of 2012 and 2014 issues of *Previews World*. Applicant objects to these documents on the grounds of relevance as by Ms. Geer's own testimony the documents were not created until 2012 and 2014 respectively. Applicant further objects to these documents on the following grounds:

- a. The document constitutes hearsay in violation of F.R.E. 802 and there is no applicable exception.

15. **Exhibit 58:** This exhibit purports to be a summary of trademarks owned by Opposer. Although these documents were not cited in Opposer's Brief, Applicant objects to these documents on the grounds of relevance as foreign registration documents have no bearing on an opposition at the TTAB. *Double J of*

Broward Inc., 21 U.S.P.Q.2d at 1612; *Johnson & Johnson.*, 183 U.S.P.Q. at 376.

Applicant further objects to these documents on the following grounds:

- a. The documents lack the authentication that F.R.E. 901(a) requires.
- b. The deponent, Ms. Geer, lacks personal knowledge to verify the information contained in the attached assignment documents as required by F.R.E. 602 because she did not become the Opposer's trustee until January 1, 2011 and she does not have personal knowledge of the facts.
- c. The document constitutes hearsay in violation of F.R.E. 802 and there is no applicable exception. The document may not be accepted for establishing the truth of the matters therein.

16. **Exhibits 59 – 62:** These documents purport to be copies of trademarks assignments. These same documents were included and were part of Exhibit 33. Accordingly, Opposer incorporates by reference its objections set forth therein.

Appendix B – Unreported Cases



1047406 Ontario Ltd. and Purifics ES, Inc. v. UVCleaning Systems, Inc. d/b/a Puralytics Corporation

Opposition No. 91194706

Trademark Trial and Appeal Board

2014 TTAB LEXIS 142

March 5, 2014, Hearing

April 14, 2014, Decided

DISPOSITION:

[*1]

Decision: The opposition is dismissed.

COUNSEL:

Myall S. Hawkins and Lisa H. Meyerhoff of Baker & McKenzie LLP for 1047406 Ontario Ltd. and Purifics ES, Inc.

Salumeh R. Loesch and David P. Petersen of Klarquist Sparkman, LLP for UVCleaning Systems, Inc.

JUDGES: Before Wellington, Adlin and Masiello, Administrative Trademark Judges.

OPINION BY: MASIELLO

OPINION:

THIS OPINION IS NOT A PRECEDENT OF THE TTAB

Opinion by Masiello, Administrative Trademark Judge:

UVCleaning Systems, Inc. ("applicant") filed an application to register the mark PURALYTICS in standard character form for "Waste water purification units; Water purification and filtration apparatus; Water purification units," in International Class 11. n1

n1 Application Serial No. 77861438, filed October 30, 2009 under Trademark Act § 1(b), 15 U.S.C. § 1051(b).

1047406 Ontario Ltd. ("Ontario Ltd.") and Purifics ES, Inc. ("Purifics ES") (collectively "opposers") opposed registration of the mark under Section 2(d) of the Trademark Act, [*2] 15 U.S.C. § 1052(d), on the ground that applicant's mark, as used in connection with applicant's goods, so resembles opposers' previously used and registered mark PURIFICS as to be likely to cause confusion, mistake or deception. Opposers allege that since December 1993, they have provided "environmental remediation products and services in the fields of soil, waste, and water treatment and air purification," including "waste water purification units, water purification and filtration apparatus, and water purification units." n2 Ontario Ltd. has pleaded ownership of U.S. Registration 2062935 for the mark PURIFICS in standard

character form for "environmental remediation services, namely, soil, waste and water treatment services and air purification services," in International Class 40. n3 Applicant denied the salient allegations of the notice of opposition.

n2 Notice of opposition, PP 1-2 (TTABvue # 1).

n3 Reg. No. 2062935 issued on May 20, 1997; Section 15 affidavit filed and acknowledged; renewed.

[*3]

The parties have filed briefs on the case. Opposers' reply brief was stricken as untimely by Board order of August 28, 2014. An oral hearing was held on March 5, 2014.

I. The record

The record includes the pleadings and, by operation of Trademark Rule 2.122, 37 C.F.R. § 2.122, the application file for applicant's mark. The record also includes the following testimony and evidence.

A. Opposers' evidence.

Opposers made of record, with their notice of opposition, a current printout of information from the electronic database records of the Patent and Trademark Office showing the current status and title of pleaded Registration. No. 2062935.

Opposers also made of record the testimony and discovery depositions (with exhibits thereto) of the following witnesses:

Testimony deposition of opposers' president Brian Butters (TTABvue ## 35 and 37).

Discovery deposition of applicant's chief executive officer Mark Owen ("Owen I," TTABvue # 36).

B. Applicant's evidence.

Applicant made of record testimony depositions (with exhibits thereto) of the following witnesses:

Testimony deposition of applicant's chief executive officer Mark Owen ("Owen [*4] II," TTABvue ## 40-42).

Testimony deposition of Marla Beier, litigation assistant for applicant's counsel (TTABvue # 38).

Testimony deposition of Heidi Van Baalen, trademark paralegal for applicant's counsel (TTABvue # 39).

Applicant also submitted notices of reliance on the following:

Opposers' responses to applicant's first set of interrogatories and first and second sets of requests for admission (TTABvue # 33).

Printouts of information from the electronic database records of the Patent and Trademark Office relating to various third-party U.S. trademark registrations (TTABvue # 34).

II. The parties.

A. Opposers.

Ontario Ltd. (or its predecessor in interest) commenced business in 1993. Purifics ES was formed in 2003 and is Ontario Ltd.'s wholly-owned subsidiary. Purifics ES is now the operating company that does business under the PURIFICS mark, and it does so under a license from Ontario Ltd. Although both companies are based in Canada, 85-90% of their business is with the United States market. n4

n4 See Butters 8:23-10:6; and opposers' response to request for admission No. 40.

[*5]

B. Applicant.

Applicant is an Oregon corporation organized in 2007, initially doing business under its corporate name UVCleaning Systems. In 2009, applicant adopted the trade name Puralytics. Applicant is headquartered in Beaverton, Oregon, and markets its goods in 36 countries, including the United States. n5 A substantial percentage of its goods are sold to customers abroad. n6

n5 Owen I 8:2-10:11; 75:24-76:8.

n6 *Id.* 78:23-79:13.

III. Opposers' evidentiary objections.

A. Opposers object to the admission of applicant's Exhibit 127, consisting of printouts of various internet web pages showing purported third-party trademarks that include the designation PUR-, on the ground that applicant did not provide the date on which such web pages were published or accessed. Applicant contends that, for this reason, the evidence does not meet the requirements for admission of internet materials as "publicly available evidence," citing *Safer Inc. v. OMS Investments Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010). [*6] n7 The objection is overruled. The requirements established by *Safer* relate to internet materials offered under a notice of reliance as self-authenticating documents within the meaning of 37 C.F.R. § 2.122(e). The materials at issue were not so offered; rather, they were entered into evidence under the testimony of Ms. Beier and Ms. Van Baalen, who explained how they accessed the materials on the internet, the dates on which they did so, and how they created the printouts of which Exhibit 127 is composed. n8 Their testimony is sufficient to admit these materials for what they show on their face.

n7 Applicant's brief at 2-3.

n8 The Beier and Van Baalen depositions are devoted in their entireties to placing Exhibit 127 in evidence.

B. Opposers object to the same Exhibit 127 on the ground that the evidence contained therein is not relevant. Opposers argue that, in order for evidence regarding third-party marks to be relevant, applicant must demonstrate that the third-party marks were actually used [*7] and well promoted and have been recognized by consumers, citing *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005). The objection is overruled. *Palm Bay* did not find such evidence excludable for lack of relevance; rather, it merely discussed the limited probative value of such evidence where the extent of use, promotion, and recognition of the third-party marks has not been shown. We agree with opposers that internet web pages, alone, do not demonstrate the extent to which a trademark has actually been used on a product or in connection with a service, if at all; however, such web pages, which are in fact available online to the general public, are relevant to show the existence of marks that

include the PUR- formative and that these marks have been disseminated online in connection with the offering of products and services relating to water treatment.

C. Finally, opposers object to the entirety of the testimony of Ms. Beier and Van Baalen, on the ground that it is inadmissible hearsay. Opposers contend that Ms. Beier and Van Baalen undertook purely ministerial duties in collecting [*8] the webpages and have no knowledge on which to base any testimony as to "whether the goods associated with the third-party marks are sold; when the goods were first sold, if ever; whether any other trade channels or forms of advertising were used with the third-party goods; or whether consumers recognized the third-party marks or the extent of their recognition of the marks." n9 The objection is overruled. Ms. Beier and Van Baalen testified only as to the manner in which they collected the materials included in Exhibit 127. It is not hearsay and is sufficient for the purposes of putting Exhibit 127 into the record, for what it shows on its face. Note also that the Board does not ordinarily strike testimony taken in accordance with the applicable rules on the basis of substantive objections; rather, such objections are considered by the Board in its evaluation of the probative value of the testimony at final hearing. *Krause v. Krause Publications Inc.*, 76 USPQ2d 1904, 1907 (TTAB 2005); *Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1326 (TTAB 1992).

n9 Opposers' brief at 4.

[*9]

IV. Applicant's evidentiary objections.

A. Applicant objects on grounds of hearsay to Mr. Butters' testimony that an exemployee named Owen Egan stated that, at a particular time, he thought that Purifics and Puralytics were the same company. *See Butters* I 44:23-45:3. Mr. Egan's statement was offered for the truth of the matter asserted (*i.e.*, to demonstrate that he was confused). Mr. Butters' account of the incident is far too vague to be within the state-of mind exception of the hearsay rule. Accordingly, we sustain the objection. *Georgia-Pacific Corp. v. Great Plains Bag Co.*, 614 F.2d 757, 204 USPQ 697, 701 (CCPA 1980). B. Under the rubric of an "evidentiary objection," applicant objects that "Opposers did not assert common law rights in their Notice of Opposition," and that they "have provided no evidence of any prior use or common law rights in the PURIFICS mark outside of their Registration." n10 To the extent that applicant seeks to characterize opposers' common law rights as an unpleaded claim as to which we should decline to receive evidence and testimony, the objection is overruled; the notice of opposition repeatedly asserts prior use of [*10] opposers' mark on goods not included in the pleaded registration. Otherwise, the "objection" merely goes to the sufficiency of opposers' proof and provides no basis for exclusion of any evidence.

n10 Applicant's brief at 21-22.

V. Standing.

Ontario Ltd. has properly made of record its pleaded Registration. No. 2062935; and the evidence demonstrates that Purifics ES makes use of the PURIFICS mark as a licensee of Ontario Ltd. n11 Opposers have thus shown that they are not mere intermeddlers and have established their standing to oppose registration of applicant's mark. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). *See also Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1118 n.8 (TTAB 2009); *Chicago Bears Football Club Inc. v. 12TH Man/Tennessee LLC*, 83 USPQ2d 1073, 1075 (TTAB 2007) [*11] (licensees have standing to oppose).

n11 Butters 8:23-10:6; opposers' response to interrogatory No. 5.

VI. Priority.

In view of opposer Ontario Ltd.'s ownership of a valid and subsisting registration of its pleaded mark, priority is not at issue with respect to the mark and services identified in that registration. *King Candy, Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). To the extent that opposers assert prior use of their mark in connection with *goods*, such priority must be proven, because it is not established by the registration.

For purposes of testing opposers' asserted priority with respect to goods, we look to the filing date of the opposed application, which is October 30, 2009. Under Section 7(c) of the Trademark Act, 15 U.S.C. § 1057(c), applicant is entitled to rely on the filing date of its application as its date of constructive use. *Larami Corp. v. Talk To Me Programs Inc.*, 36 USPQ2d 1840 (TTAB 1995); [*12] *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542 (TTAB 1991). Although applicant's witness stated that applicant first used its mark "in the beginning of 2009," n12 the evidence does not clearly establish any date of use earlier than the filing date of the application. In any event, as discussed below, opposers have demonstrated use of their mark on goods prior to this time.

n12 Owen I 13:25-14:18.

The evidence of opposers' early use of their mark is very scant, but we find it sufficient to show use of the mark in connection with goods earlier than 2009. A news article from June 1998 makes note of opposers' Photo-Cat water treatment systems and includes a photograph of equipment bearing the PURIFICS mark. n13 An advertisement, bearing the PURIFICS mark, for opposers' booth at the Brownfields 2004 trade show makes reference to the Photo-Cat air/water treatment systems, with a photograph of the product. n14 (If the mark is on the goods, it is not legible.) A certificate of [*13] NSF International, addressed to Purifics ES and dated June 6, 2008, relates to opposers' Photo-Cat product, stating, "NSF International Certifies that the products appearing on this Listing conform to the requirements of NSF/ANSI Standard 61 - Drinking Water System Components - Health Effects." n15 Opposers' witness testified that the certification "is a requirement in many states in the U.S. before you can sell your wares for drinking water application. ... It's an important third-party validation that your product, in this case, our photocatalytic product, does not do any harm to the water. It doesn't release any chemicals or other undesirable minerals or metals to the water." n16 The record contains no documentation or even testimony relating to early sales or shipments of goods bearing the PURIFICS mark. The testimony of opposers' witness was vague and reticent with respect to details of early use of the mark on goods. Nonetheless, we find the evidence sufficient to demonstrate that prior to 2009, opposers associated the designation PURIFICS with their photocatalytic water purification system, at least as a trade name.

n13 "New remediation technology uses titanium dioxide, light to destroy contaminants in water," *U.S. Water News*, June, 1998, p. 16. See Butters Exhibit 13.

[*14]

n14 Butters Exhibit 16.

n15 Butters Exhibit 12.

n16 Butters 17:8-18:11.

In sum, priority is not an issue with respect to the services recited in opposers' pleaded registration vis-[#x00E0]-vis the goods listed in the application, and opposers have demonstrated priority with regard to their use of the PURIFICS mark on a water treatment unit.

VII. Likelihood of confusion.

Our determination of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.* 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

A. The parties' goods and services.

We consider first the similarity or dissimilarity between applicant's goods and the services recited in opposers' registration. Applicant seeks registration of its mark for:

Waste water purification units; Water purification and filtration apparatus; Water purification units.

Opposers' [*15] pleaded registration covers the following services:

Environmental remediation services, namely, soil, waste and water treatment services and air purification services.

Opposers' recitation of services is broad. The phrase "water treatment services" clearly encompasses water purification services; and presumably the provision of water treatment services would likely entail the use of "Water... filtration apparatus" or "Water purification... apparatus," as identified in applicant's application. The question before us, however, is whether applicant's goods and opposers' services are related in such a way that they may be encountered by the same persons under circumstances that could, because of the similarity of the marks used with them, give rise to the mistaken belief that they originate from or are in some way associated with the same producer. *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1410 (TTAB 2010). The commercial aspects of environmental remediation services and water purification equipment are not a matter of common knowledge. Accordingly, it is not a foregone conclusion that applicant's goods and opposers' services are commercially [*16] related merely because the goods might be used in rendering the services. Opposers have presented little in the way of evidence or testimony to persuade us that customers would believe that a single company would offer both the services and the goods. Indeed, the testimony and evidence provide only a vague idea of the nature of opposers' services, n17 and at times opposers' witness did not appear to appreciate the difference between providing remediation services and selling customized remediation equipment. n18 Applicant contends that it sells water purification apparatus but does not provide environmental remediation services of any kind. n19 Opposers, for their part, have demonstrated that they sell water purification *goods*, but their involvement in remediation *services* is established primarily by the statutory presumptions accorded their pleaded registration under 15 U.S.C. § 1057(b). Lacking better evidence than this, we cannot conclude that there is a commercial relationship between applicant's goods and opposers' services such that customers would be likely to suffer source confusion.

n17 When asked to list the services that opposers offer, Mr. Butters listed design services, startup services, after-sales support, "control or software services for our products," energy services, engineering services, and certification services, none of which squarely match the services recited in opposers' registration. See Butters 19:2-20:6.

[*17]

n18 Butters 46:4-11, in which the witness characterized applicants as providing a service.

n19 Owen I 54:3-6; Owen II 10:22-11:6; 13:12-16.

We next compare opposers' goods with those identified in the application. Opposers have shown that they produce, among other goods, a water purification unit called Photo-Cat that is marked with the PURIFICS brand. Opposers' website describes the product as follows:

Photo-Cat purifies water of chemicals, biologicals and certain metals to very high standards of purity.

Photo-Cat systems will treat water with a wide range of organics and concentrations, suspended oil, turbidity, high levels of total dissolved solids, and metals. These systems are fully automated and DO NOT require chemical oxidants.

...

Photo-Cat is produced to meet the specifications of a variety of clients in remediation, industrial, nuclear, military, pharmaceutical, potable, metals removal, process and laboratory applications.

These specifications can include NSF certification, food grade construction, pressure vessel certification, leak proof designs, [*18] customer specific materials of construction, specific instrumentation, performance factors, durability, and wash-down capability. n20

Opposers' witness described the main markets for opposers' goods as "municipal, industrial, and remedial," and explained as follows:

Municipal water is drinking water and it's water reuse and it's wastewater treatment.

...

[Water reuse] means that you clean up the water, that it can be reused for drinking water or other residential uses.

...

[Wastewater treatment is] upgrading the sewage to a reuse standard.

...

Industrial market involves... cleaning up the water that's discharged from industry... cleaning up water going into industry... reusing the water in industry.

...

[Industrial customers] are various departments of the U.S. government....[and] private entities.

...

[Remedial] involves cleaning up groundwater for surface water discharge, reinjection, discharge to wastewater treatment plants. ... [Groundwater for surface water discharge] means we clean up the contaminated groundwater such that it's clean enough that it can be discharged back into the environment directly.

...

[Remedial [*19] customers are] Industry and municipalities. n21

n20 Butters Exhibit 14 at 000126-7.

n21 Butters 64:24-67:7.

In our analysis, when we consider applicant's goods we look only to the goods as identified in the application (even though the record may show that applicant's goods are somewhat different in nature from those of opposers), because the application defines the scope of the registration that applicant seeks. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, ___ F.3d ___, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014), *Octocom Syst. Inc. v. Houston Computers Svcs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Doing so, we find the parties' goods to be legally identical, as it is clear that opposers' goods, as shown by the evidence, are encompassed within the scope of "Water purification and

filtration apparatus; Water purification units." Accordingly, with respect to the parties' goods, we find that the *du Pont* factor of the similarity [*20] or dissimilarity of the goods favors a finding of likelihood of confusion.

B. Customers; channels of trade; conditions of sale.

Applicant has submitted evidence and testimony to demonstrate that its goods consist of two distinct products (and several variations thereof) that are offered to quite distinct customer classes. One product, called SolarBag, is a small container for water that, when exposed to the sun, will purify the water and render it potable. It is marketed to recreational users such as campers, fishers, and backpackers; it is marketed to non-governmental organizations such as UNICEF and USAID, primarily for use abroad; and it is also appropriate for inclusion in emergency preparedness kits. n22 The other product, called Shield, is marketed to "light industry," especially to laboratories for the production of ultra-pure water and treatment of waste emanating from the laboratory. n23

n22 Owen I 31:13-24.

n23 *Id.* 32:3-33:4.

Although applicant's customers may appear to be [*21] distinct from opposers' (discussed above in part VII(A)), these distinctions arise from differences between the parties' goods that are not reflected in applicant's identification of goods. Opposers correctly argue that, because the application covers water purification units without limitation, we must consider that applicant's goods may be purchased by all potential customers for such goods. *Stone Lion* 110 USPQ2d at 1162; *Octocom*, 16 USPQ2d at 1787-8; *Paula Payne Products Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76 (CCPA 1973). Similarly, we must assume that applicant's goods travel through all normal trade channels for such goods, *id.*, and such channels of trade would include those in which opposers' goods are found.

Considering the breadth of applicant's identification of goods, the potential customers for such goods would include the types of municipalities, government agencies, and industries to which opposers offer their goods. *Stone Lion*, 110 USPQ2d at 1163. Accordingly, the *du Pont* factor of the similarity or dissimilarity of established, likely to continue trade channels favors a finding [*22] of likelihood of confusion.

We note applicant's argument that customers for remediation services and water purification units are sophisticated and exercise great care in selecting such goods and services. n24 However, the evidence shows that customers for applicant's SolarBag product, which has been offered on Amazon.com for \$ 75.05, n25 include consumers such as campers and backpackers. n26 More importantly, while applicant's customers may in fact include highly sophisticated customers, we cannot base our decision on potential purchasers not specified in the identification of applicant's goods. *Stone Lion*, 110 USPQ2d at 1163. The care and sophistication of potential customers is a neutral factor in our analysis.

n24 Applicant's brief at 33; Owen II 19:13-20:10; 29:24-30:6.

n25 Owen I, Exhibit 6.

n26 Owen I 31:13-24.

C. The marks at issue.

We next consider the similarity or dissimilarity of the marks PURIFICS and PURALYTICS in terms of appearance, sound, meaning, [*23] and overall commercial impression. *Palm Bay Imports*, 73 USPQ2d 1689. We base our determination on a consideration of the marks in their entireties. *Id.*; *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). *See also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981). However, an analysis of individual aspects of the marks is a permissible part of our determination. *Price Candy Company v. Gold Medal Candy Corporation*, 220 F.2d 759, 42 C.C.P.A. 831, 1955 Dec. Comm'r Pat. 143, 105 USPQ 266, 268 (CCPA 1955). In fact, there is nothing improper in stating that, for rational reasons, more or less weight

has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entirety. *Stone Lion*, 110 USPQ2d at 1161.

Opposers emphasize that both marks at issue begin with the syllable PUR- and end with the syllable -ICS; and that customers are likely to be more strongly impressed by the initial component of a mark than the remainder of it. n27 Opposers also argue that "both marks suggest the idea of water purification goods and services"; [*24] and that both parties selected the syllable PUR- in order to convey this meaning. n28 Moreover, opposers claim that in selecting their mark, they "wanted a mark that suggested to consumers the idea that purification was accomplished using photocatalytic means," and that in this regard the motives of both parties, in selecting their respective marks, were the same. n29

n27 Opposers' brief at 14-16.

n28 *Id.* at 16-17.

n29 *Id.* at 17; see *Butters* 10:21-11:11.

While we acknowledge the elements of similarity between the marks, we also note substantial differences. The middle components of the two marks, -IF- in the case of opposers and -ALYT- in the case of applicant, are different in all respects and have a substantial impact on the respective commercial impressions created by the marks. In opposers' mark, the letters -IF- combine with the letters before and after them to powerfully suggest the word "purification," inasmuch as the mark and the word share the seven sequential letters [*25] PURIFIC- in common. This combination of letters might also call to mind the common word "terrific" in the minds of customers. By contrast, in applicant's mark the combination of PUR- with -ALYT- results in a seemingly arbitrary string of letters, not suggestive of any common word. Instead, -ALYT- combines with the letters following it, -ICS, to strongly suggest well known words such as "catalytic" and "analytic." In this regard, it differs pointedly from opposers' mark. Despite opposers' contention that they too selected their mark in order to suggest the "photocatalytic" process that is a feature of the goods, it is unlikely that customers would derive such an impression from the letters -ICS alone or from opposers' mark as a whole. Thus, while the impression of "catalytic" is present in applicant's mark, it is absent from opposers' mark.

In considering the common elements of the marks, we find that the element PUR- is only weakly distinctive with respect to goods and services that relate to a purification process. Where the common elements of conflicting marks are suggestive of the goods or services at issue, the likelihood of confusion is reduced. See, e.g., *Keebler Co. v. Murray Bakery Products*, 866 F.2d 1386, 9 USPQ2d 1736 (Fed. Cir. 1989) [*26] (*PECAN SANDIES* and *PECAN SHORTEES*); *Magnaflux Corp. v. Sonoflux Corp.*, 231 F.2d 669, 43 C.C.P.A. 868, 1956 Dec. Comm'r Pat. 248, 109 USPQ 313 (CCPA 1956) (*MAGNAFLUX* and *SONOFLUX*); and *Land-O-Nod Co. v. Paulison*, 220 USPQ 61 (TTAB 1983) (*CHIROPRACTIC* and *CHIRO-MATIC*). In addition, the shared -ICS component of the two marks is an extremely common suffix that is found in many commonplace words of diverse meaning (e.g., politics, mathematics, aerobics, economics). We find that this shared component of the two marks is not likely to suggest to customers that the goods and services of the parties emanate from a common source.

In sum, we find that the two marks at issue are different from each other with respect to the relevant considerations of appearance, sound, meaning or connotation, and overall commercial impression. This *du Pont* factor weighs against a finding of likelihood of confusion.

D. Absence of actual confusion.

We note applicant's argument that there has been no actual confusion involving the parties' marks, despite co-existence in the marketplace since 2009. n30 Indeed, the absence of confusion has been proven by admission. n31 While evidence of actual confusion is [*27] highly probative, its absence is not, unless it is accompanied by evidence demonstrating that, in light of the parties' actual business activities, confusion, if likely, would have occurred. No such evidence is before us. Therefore, we find the lack of evidence of actual confusion to be a neutral factor in our analysis of likelihood of confusion.

n30 Applicant's brief at 34-35.

n31 Opposers' response to request for admission No. 1; opposers' response to interrogatory No. 3.

E. Relative fame of the marks.

Opposers argue that their mark is more famous than applicant's mark; that opposers have generated more sales of their goods and services under the PURIFICS mark than has applicant under the PURALYTICS mark; that opposers have "outspent" applicant in terms of promotion of their goods; and that opposers' mark has been in the market much longer than applicant's mark. n32 Opposers have not made any substantial evidentiary showing of the fame, or even commercial strength, of their mark and, accordingly, [*28] this factor is neutral in our analysis.

n32 Opposers' brief at 17-18.

VIII. Conclusion.

We have considered all of the evidence of record and all arguments of the parties relevant to the issues before us, including those not specifically discussed herein. Considering all of the *du Pont* factors, we find the dissimilarity of the marks to be dispositive of this case. While applicant's goods are legally identical to opposers', we find that applicant's mark is not likely to give rise to confusion, mistake or deception as to the source of applicant's goods. *See Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) ("We know of no reason why, in a particular case, a single *du Pont* factor may not be dispositive.")

Decision: The opposition is dismissed.

Legal Topics:

For related research and practice materials, see the following legal topics:

Trademark LawLikelihood of ConfusionSimilarityAppearance, Meaning & SoundGeneral OverviewTrademark LawU.S. Trademark Trial & Appeal Board ProceedingsOppositionsGroundsTrademark LawU.S. Trademark Trial & Appeal Board ProceedingsOppositionsStanding



Pfizer, Inc. v. Gregg Hamerschlag

Opposition No. 118,181

Trademark Trial and Appeal Board

2001 TTAB LEXIS 729

September 27, 2001, Decided

JUDGES: [*1]

Before Cissel, Chapman, and Wendel, Administrative Trademark Judges.

OPINION:

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE T.T.A.B.

By the Board:

Pfizer, Inc. filed a notice of opposition to registration of the mark CLIAGRA for "natural, herbal vitamins and mineral supplements, namely an herbal aphrodisiac to enhance female sexual desire" n1 on the grounds that applicant's mark so resembles opposer's previously used and registered mark VIAGRA for "compound for treating erectile dysfunction" (Registration No. 2,162,548 n2) as to be likely to cause confusion, mistake or deception; and that applicant's CLIAGRA mark will cause dilution n3 of the famous and distinctive quality of opposer's VIAGRA mark.

n1 Application Serial No. 75/599,401 was filed on December 4, 1998 under Trademark Act Section 1(b) based on applicant's assertion of a *bona fide* intention to use the mark in commerce.

n2 Registration No. 2,162,548, issued on June 2, 1998.

n3 Opposer is advised that dilution claims are properly based not on Trademark Act Section 2(f) of the Trademark Act (cited by opposer in its notice of opposition) but on Section 43(c). Further, opposer is advised that its dilution claim was not properly pleaded insofar as there is no allegation as to when opposer's mark became famous. *Polaris Industries, Inc. v. DC Comics*, 59 USPQ2d 1798 (TTAB 2000).

[*2]

On March 27, 2001, opposer filed a motion to amend its notice of opposition to add claims (i) that application Serial No. 75/599,401 is void *ab initio* under Trademark Act Section 1(b) because applicant did not have a *bona fide* intent to use the mark in commerce when he filed the application, and (ii) that applicant made an invalid assignment of his intent-to-use application under Trademark Act Section 10. On the same date, opposer also filed a motion for summary judgment on the Section 1(b) and Section 10 claims.

Turning first to opposer's motion to amend, which was accompanied by a signed copy of the amended notice of opposition, we note that the Board received no opposition to the motion. Further, on May 16, 2001, applicant filed its answer to the amended notice of opposition. n4 Opposer's motion to amend its notice of opposition is granted pursuant to Fed. R. Civ. P. 15(a) and Trademark Rule 2.107. Accordingly, both opposer's amended notice of opposition and applicant's answer thereto are accepted.

n4 Both applicant's original answer and answer to the amended notice of opposition seek an award of "all costs, including a reasonable attorney's fee". Pursuant to Trademark Rule 2.127(f), the Board will not award attorneys' fees or other expenses to any party. See *Duke University v. Haggard Clothing Co.*, 54 USPQ2d 1443

(TTAB 2000); Trademark Trial and Appeal Board Manual of Procedure (TBMP) § 502.06. Applicant's request is denied.

[*3]

Turning to opposer's motion for summary judgment, the granting of a motion for summary judgment is appropriate where there exists no genuine dispute as to any material fact and where the moving party is entitled to judgment as a matter of law. *See* Fed. R. Civ. Pro. 56(c); *Celotex Corp. v. Catrett*, 477 U.S. 317, 106 S. Ct. 2548 (1986).

We consider first the pleaded ground that applicant did not have a *bona fide* intent to use the mark in commerce when the application was filed and the application is void *ab initio* under Section 1(b). In support of its motion, opposer relies, *inter alia*, on applicant Gregg Hamerschlag's deposition testimony that he has invested no money in the development of the CLIAGRA product and possesses no business plans to develop said product; and applicant's discovery responses producing, in response to more than 40 requests for documents relating to applicant's CLIAGRA mark, only copies of opposer's three letters to applicant regarding the mark and a copy of his involved trademark application.

In opposing the motion for summary judgment, Mr. Hamerschlag relies on his deposition testimony, [*4] and his affidavit n5 which show that at the time Hamerschlag filed his trademark application for the CLIAGRA mark he intended to market the product in magazines and other print media; that he conducted research before filing the application and his research demonstrated to him that he could buy, package, and sell the product with his own funds; that because he would not be seeking investors or borrowing funds to launch the product he did not see the necessity of a formal business plan; that he did not want to invest time and effort on building a brand until he secured rights to the name; and that his intention was to develop the product upon completion of the registration process.

n5 In its reply brief, opposer included a "motion" to strike Mr. Hamerschlag's entire affidavit (submitted with applicant's opposition to the motion for summary judgment) on the ground that it contradicts his prior deposition testimony. A party cannot create an issue of fact by supplying an affidavit contradicting his prior deposition testimony without explaining the contradiction or attempting to resolve the disparity. *Sinskey v. Pharmacia Ophthalmics, Inc.*, 982 F.2d 494, 25 USPQ2d 1290 (Fed. Cir. 1992) *cert. denied*, 508 U.S. 912 (1993). Here, upon careful review of the deposition testimony and affidavit, we find that Mr. Hamerschlag's affidavit does not contradict so much as it clarifies and explains responses given in his deposition testimony. Opposer's motion to strike the Hamerschlag affidavit is denied.

We hasten to add that, insofar as the deposition testimony establishes that applicant had plans to manufacture and market its herbal aphrodisiac, the deposition testimony alone raises a genuine issue of material fact regarding applicant's *bona fide* intent to use the involved mark in commerce and striking the affidavit would not alter the outcome of the summary judgment motion in this regard.

Attached to applicant's affidavit were additional documents which applicant claims show his *bona fide* intent to use the mark in commerce. In his affidavit, applicant states that he did not remember the existence of these documents at the time of his deposition and only discovered them at an unspecified later point.

Also in its reply brief opposer included another "motion" to strike these documents on the ground that they were not disclosed during discovery, and applicant's discovery responses were not supplemented when applicant found the responsive documents. Pursuant to Fed. R. Civ. P. 37(c), opposer's motion is granted and we have given the documents attached to Mr. Hamerschlag's affidavit no consideration in reaching our decision herein.

[*5]

As a general rule, the factual question of intent is particularly unsuited to disposition on summary judgment. *See Copelands' Enterprises, Inc. v. CNV, Inc.*, 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991). The Board has held, however, that the absence of any documentary evidence regarding an applicant's *bona fide* intention to use a mark in commerce is sufficient to prove that an applicant lacks such intention as required by Section 1(b) of the Trademark Act, unless other facts are presented which adequately explain or outweigh applicant's failure to provide such documentary evidence. *See Commodore Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993). Here, applicant's deposition testimony and affidavit regarding his modest and informal business plan for his intended use of the mark CLIAGRA is sufficient to raise a genuine issue as to his *bona fide* intention to use a mark in commerce in the context of opposer's motion for summary judgment. *See Lane Ltd. v. Jackson International Trading Co.*, 33 USPQ2d 1351, 1356 (TTAB 1994).

After a careful review of the parties' arguments, and drawing all reasonable inferences in favor [*6] of applicant as the non-moving party, we find that disposition of the issue of applicant's *bona fide* intention to use the mark in commerce by summary judgment is inappropriate. There is a genuine issue of fact regarding applicant's *bona fide* intention to use the involved mark in commerce. In view of the foregoing, opposer's motion for summary judgment is denied on the Section 1(b) claim.

We next consider opposer's motion for summary judgment on the ground that applicant filed an invalid assignment of the intent-to-use application and the application is void *ab initio* under Trademark Act Section 10.

Opposer has moved for summary judgment on the ground that the unlawful assignment voids the application because Gregg Hamerschlag did not have an ongoing and existing business under the CLIAGRA mark that could be assigned to a successor and thus did not meet the statutory exception for assignment of intent-to-use applications. In its motion opposer relies upon the undisputed facts that applicant has invested no money in the development of the CLIAGRA product; that since filing the application, applicant has done nothing to bring the product to market; that when applicant assigned [*7] the application, he did not assign related business assets to Cliagra LLC; and that applicant assigned nothing other than the trademark to Cliagra LLC. Opposer also relies, *inter alia*, on applicant Gregg Hamerschlag's deposition testimony in which applicant states that "at the time I transferred the mark to Cliagra LLC, I as an individual did not have any business, ongoing business using the mark." (Hamerschlag Dep. Pages 56-57).

In support of his position that he did have an ongoing and existing business, and thus the assignment of his intent-to-use application for the involved mark fit the statutory exception for an assignment of an intent-to-use application to a successor to the business, Mr. Hamerschlag submits his affidavit in which he states that Cliagra LLC is a limited liability company organized under the laws of Vermont; that he is the sole member; that he formed Cliagra LLC after learning of opposer's opposition to registration of the CLIAGRA mark; and that he assigned his application to Cliagra LLC on advice of counsel in order to protect himself from personal liability. Applicant argues that Cliagra LLC is clearly a successor business to Gregg Hamerschlag and that [*8] both the businesses of Cliagra LLC and Gregg Hamerschlag were ongoing and existing at the time of the assignment.

The record makes clear that Gregg Hamerschlag filed application Serial No. 75/599,401 under Trademark Act Section 1(b) on December 4, 1998; that applicant assigned application Serial No. 75/599,401 to Cliagra, LLC on August 9, 1999 n6; and that applicant assigned the application prior to the filing of an allegation of use under Section 1(c) or Section 1(d).

n6 The U. S. Patent and Trademark Office Assignment Branch records indicate that the assignment was recorded at Reel 1991, Frame 0121.

Trademark Act Section 10 states, in pertinent part (*emphasis added*):

A registered mark or a mark for which an application to register has been filed shall be assignable with the good will of the business in which the mark is used, or with that part of the good will of the business connected with the use of and symbolized by the mark. Notwithstanding the preceding sentence, no application to register a mark under section 1(b) shall be assignable prior to the filing of an amendment under section 1(c) to bring the application into conformity with section 1(a) or the filing [*9] of the verified statement of use under section 1(d), *except for an assignment to a successor to the business of the applicant, or portion thereof, to which the mark pertains, if that business is ongoing and existing.*

The legislative history of Section 10 states that "Permitting assignment of applications before a mark is used would conflict with the principle that a mark may be validly assigned only with some of the business or goodwill attached to use of the mark and would encourage trafficking in marks." S. 1883, 100th Cong., 1st Sess., 133 Cong. Rec. § 16552 (daily ed. November 19, 1987), *reprinted in* United States Trademark Association, The Trademark Law Revision Act of 1988 (1989). n7 The Board has held that the Section 10 requirement that applicant's business be "ongoing and existing" fills a loophole that would permit otherwise prohibited assignments. "For example, an 'intent to use' applicant may intend to create a new business in which the mark will be used but decide, after the application is made, not to do so. Without the requirement that the business be 'ongoing and existing,' the applicant would be able to assign the marks that are the subject of the [*10] 'intent to use' application to another business, which purports to be a successor to the first company's no longer existing business. By closely limiting assignments, these provisions will protect against trafficking in marks and help ensure that the intention of the 'intent to use' applicant is *bona fide*." *The Clorox Co. v. Chemical Bank*, 40 USPQ2d 1098 (TTAB 1996). *See also, In re Circuit City Stores West Coast Inc.*, 40 USPQ2d 1536 (Comm.

1996) (statutory exception not met when applicant wishes to transfer ownership of applications to sister subsidiary "since no other assets are intended to be transferred with the subject applications"). Unless the statutory exception is met, the legal effect of assigning an intent-to-use application, prior to the filing of a verified allegation of use, is that the application is void. n8 *The Clorox Co. v. Chemical Bank*, *supra*.

n7 We note that the assignment document, in which Hamerschlag merely transferred his "title and interest" in the application, is a naked transfer which does not convey to the assignee any goodwill associated with the mark. A trademark cannot be sold or assigned apart from the good will it symbolizes. Trademark Act Section 10; and *The Clorox Co. v. Chemical Bank*, 40 USPQ2d 1098 (TTAB 1996). Accordingly, the assignment is also invalid as a prohibited assignment in gross.

[*11]

n8 We note that the recordation of transfer of interest documents at the U.S. Patent and Trademark Office Assignment Branch is a ministerial act. It does not include a decision on the legal sufficiency or the legal effect of the document(s) offered for recordation.

Upon careful consideration of the arguments and evidence presented by the parties, we find that there is no genuine issue of material fact that applicant did not have an ongoing and existing business pertaining to the CLIAGRA mark at the time he assigned his application. Applicant does not claim that he is or was in the business of selling the identified herbal aphrodisiacs, the business pertaining to the CLIAGRA mark. Instead, applicant specifies "the battle against Pfizer for use of the mark 'Cliagra' ...was its only business then and that is its only business now." Unwittingly or not, a party who has no business except obtaining a trademark on the basis of intent to use and who prior to starting a business assigns that application to another falls squarely into the trademark trafficking activity that Section 10 is intended to preclude.

In sum, we find that there is no genuine issue of material fact that applicant [*12] did not have an ongoing and existing business pertaining to the involved mark and, as a result, applicant did not meet the statutory exception when he assigned his intent-to-use application to the "successor" to the as-yet unrealized business to which the CLIAGRA mark pertains. Therefore, as a matter of law the assignment of application Serial No. 75/599,401 violated Section 10 of the Trademark Act, and the application is void. Opposer's motion for summary judgment is granted on the ground based on Section 10 of the Trademark Act, and judgment is entered against applicant on that basis.

Accordingly, the opposition is sustained on opposer's Section 10 ground, and application Serial No. 75/599,401 is refused registration as being void.

Legal Topics:

For related research and practice materials, see the following legal topics:

Trademark LawConveyancesAssignmentsTrademark LawProtection of RightsGeneral OverviewTrademark LawU.S. Trademark Trial & Appeal Board ProceedingsOppositionsGrounds

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3 of 7 DOCUMENTS

SMART CHOICE FOOD SALES, LTD. v. NATURE'S WAY PRODUCTS, INC.

Cancellation No. 92044270

Trademark Trial and Appeal Board

2006 TTAB LEXIS 123

March 29, 2006, Mailed

JUDGES: [*1]

Before Quinn, Hohein and Rogers, Administrative Trademark Judges.

OPINION:

THIS OPINION IS NOT CITABLE AS PRECEDENT OF THE T.T.A.B.

By the Board:

Smart Choice Food Sales, Ltd. seeks to cancel the registration owned by Nature's Way Products, Inc. for the mark THE GOLD STANDARD for "vitamins and nutritional dietary supplements" in International Class 5 n1 on the ground that respondent has abandoned the mark by having failed to use the mark in commerce "for a period in excess of three years" with no intent "to resume use of the mark in connection with such goods." n2

n1 Reg. No. 1,500,164, issued on August 16, 1988 on the Principal Register, which claims a date of first use in commerce of January 25, 1988; Section 8 and 15 affidavit acknowledged March 29, 1995.

n2 The petition to cancel was filed on February 7, 2005.

Respondent, in its answer, has denied the essential allegations of the petition to cancel and pleaded certain affirmative defenses.

This case now comes up for consideration of petitioner's motion, filed July 29, 2005, for summary judgment on the ground of abandonment. The motion is fully briefed.

In support of its motion, petitioner contends that [*2] since the commencement of the proceeding, respondent has failed to produce a single piece of evidence that the registered mark THE GOLD STANDARD was ever used in commerce; that there is not a single fact in the record showing use by respondent or rebutting the showing of abandonment; that abandonment can be presumed from respondent's failure to provide evidence of sales, usage or affixation of the involved mark to any of its products in response to petitioner's discovery requests, which were largely directed to the central issue of abandonment; that respondent's failure to provide substantive answers to petitioner's interrogatories and its production of only four documents in response to petitioner's document requests supports a showing of abandonment; and that the four documents produced by respondent do not address the abandonment issue nor do they show that THE GOLD STANDARD was ever used as a mark. n3

n3 With regard to the four documents produced, petitioner argues that respondent has failed to show when or whether these documents were actually used in advertising the products (2005 advertisement -- B-2) or affixed to the goods (2005 document -- B-1 and 1994 label -- B-3); and that the document dated 2002 is not evidence of any actual or ongoing usage or even resumption following nonusage nor can an intent to resume use be inferred from the document.

[*3]

As evidence to support its position, petitioner has provided the declaration of Robert Seader, president of petitioner, who avers that he undertook a factual investigation of the abandonment of respondent's THE GOLD STANDARD mark; that he examined respondent's products in stores, reviewed respondent's websites, product literature, and advertisements through Internet searches and found no usage of THE GOLD STANDARD mark; and that he called respondent to inquire about THE GOLD STANDARD products and "was informed that no such name existed." Petitioner has also submitted the four documents produced by respondent in response to petitioner's document discovery requests as prima facie evidence of abandonment.

In response, respondent argues that petitioner's president's investigation into respondent's use is unreliable and irrelevant and does not establish abandonment as matter of law; that the documents produced by respondent in discovery create questions of fact; that use of the subject mark in commerce and in a printed publication as recently as 2005 "affirmatively evidence intent to utilize the mark"; and that petitioner has failed to demonstrate an absence of issues of material fact [*4] as to respondent's intent to abandon the mark.

In support of its response, respondent has provided the declaration of Robyn Phillips, respondent's counsel. In her declaration, respondent's counsel avers that petitioner has not produced documentary evidence with regard to its factual investigation into respondent's alleged abandonment of THE GOLD STANDARD mark (i.e., the phone call and Internet search); and that the documents produced by respondent establish that it uses the mark "as a secondary mark in connection with goods."

Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. Fed. R. Civ. P. 56(c). The party moving for summary judgment has the initial burden of demonstrating the absence of any genuine issue of material fact and that it is entitled to judgment as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986) and *Sweats Fashions Inc., v. Pannil Knitting Co., Inc.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). The evidence must be viewed in a light most [*5] favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. See *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993).

Turning to the merits of petitioner's motion, we find that there is no genuine issue of material fact that respondent ceased using THE GOLD STANDARD mark sometime after 1994 for a period of no less than three consecutive years. We agree with petitioner that the discovery responses made of record are sufficient to establish a prima facie case of abandonment. n4

n4 Section 45 of the Trademark Act, 15 U.S.C. Section 1127, provides that a mark is abandoned when "its use has been discontinued with intent not to resume use. . . . Nonuse for three consecutive years shall be prima facie evidence of abandonment."

Irrespective of events in 2005 when, evidently, respondent may have made some use of the mark, we find that, by that time, respondent had abandoned its right to THE GOLD STANDARD mark through nonuse. Simply put, the record is devoid of any evidence to show that the registered mark was used in the ordinary course of trade on any of the [*6] goods listed in the involved registration. Despite petitioner's various discovery requests therefor, respondent furnished no evidence showing that there was never a three-year period prior to 2005 in which it had failed to make any sales or other use of THE GOLD STANDARD mark, whether such use be on receipts, tags, labels, advertisements or otherwise. Instead, the only documentation provided by respondent showing possible use of THE GOLD STANDARD mark for a date prior to 2005 is a label with a 1994 copyright notice. The total lack of corroborating evidence of sales and use of such goods under the mark clearly establishes a prima facie case of abandonment of respondent's THE GOLD STANDARD mark.

We also find that there is no genuine issue that the 2005 uses of the mark, if they were used in connection with the goods at all, represent a new and separate use of the mark. These uses cannot serve to cure the prior abandonment inasmuch as abandonment of a mark cannot be reversed by subsequent re-adoption of a mark. *Parfums Nautee Ltd. v. American International Industries*, 22 USPQ2d 1306, 1310 (TTAB 1992).

Accordingly, we find that as a matter of law, petitioner has established [*7] a prima facie case of abandonment of the mark.

Such a prima facie case of abandonment eliminates petitioner's burden of establishing the intent element of abandonment as an initial part of the case and creates a rebuttable presumption that respondent abandoned its mark without an intent to resume use. See *Rivard v. Linville*, 133 F.3d 1446, 45 USPQ2d 1374, 1376 (Fed. Cir. 1998); and *Imperial*

Tobacco Ltd. v. Philip Morris, Inc., 899 F.2d 1575, 14 USPQ2d 1390, 1393 (Fed. Cir. 1990). The presumption shifts the burden to respondent to produce evidence that it intended to resume use of the mark. See *Rivard v. Linville*, *supra*; and *Cerveceria Centroamericana S.A. v. Cerveceria India, Inc.*, *supra*.

Thus, in the case of a motion for summary judgment, when the moving party supports its position by evidence sufficient to indicate that there is no genuine issue of material fact, and that the moving party is entitled to judgment as a matter of law, the burden shifts to the nonmoving party to demonstrate the existence of specific, genuinely-disputed facts that must be resolved at trial. In this case, the question is whether respondent, like [*8] any other registrant who has not made use for at least three years, has put forth sufficient evidence to at least raise a genuine issue of material fact of intent to resume use. *Imperial Tobacco Ltd. v. Philip Morris Inc.*, *supra*.

After reviewing the evidence in a light most favorable to respondent, we conclude that respondent has not raised a genuine issue of fact to rebut the presumption that respondent abandoned its mark without an intent to resume use. Respondent has provided no documentary evidence showing specific actions taken to plan for resumption of use but has only offered unsupported statements n5 in its responsive brief regarding its continuing intent. The declaration from its counsel does not go to respondent's intent to resume use and only asserts that THE GOLD STANDARD is a secondary trademark. n6 We also find little value in the 2002 "survey" document which was produced in discovery inasmuch as "an affirmative desire by the registrant not to relinquish a mark is not determinative of the intent element of abandonment under the Lanham Act." *Imperial Tobacco*, 45 USPQ2d at 1394. See also, *Rivard v. Linville*, 45 USPQ2d at 1376 [*9] ("registrant's bare proclamations of its intent to resume use . . . are entitled to little, if any, weight"). Further, we cannot agree with respondent that the 2005 documents produced in discovery are evidence of a continuing intent to use the mark. As stated above, the 2005 uses are clearly new use of the mark after abandonment.

n5 The unsupported statements are made by respondent's attorney.

n6 We note that respondent's attorney could not submit averments as to respondent's use or its intent to resume use.

In view of the foregoing, we conclude that respondent has not raised a genuine issue of material fact to overcome the presumption of no intent to resume use of the mark, after years of nonuse of the mark. Thus, and provided that the matter below is resolved in its favor, petitioner appears to be entitled to summary judgment in its favor on the issue of abandonment.

One further matter remains, however. Specifically, in order to prevail herein, petitioner must establish not only a valid ground for cancellation but must prove its standing to bring the petition to cancel as well. *Medinol Ltd. v. Neuro Vasx Inc.*, 67 USPQ2d 1205, 1210 (TTAB 2003). [*10] However, petitioner has not submitted any evidence on this point.

In view thereof, petitioner is allowed until **THIRTY DAYS** from the mailing date of this order in which to submit a showing that there is no genuine issue of fact as to its standing. *Paramount Pictures Corp. v. White*, 31 USPQ2d 1768, 1775-76 (TTAB 1994). If petitioner's showing is sufficient to establish petitioner's standing, the motion for summary judgment on the issue of abandonment will be granted, and the petition for cancellation will be granted. If petitioner's showing is not sufficient on the issue of standing, proceedings will resume on the issue of petitioner's standing to bring this proceeding.

Proceedings herein remain otherwise SUSPENDED pending petitioner's response.

Legal Topics:

For related research and practice materials, see the following legal topics:

Trademark LawConveyancesGeneral OverviewTrademark LawProtection of RightsAbandonmentIntentional AbandonmentTrademark LawProtection of RightsAbandonmentIntentional Nonuse